Opinion of the United States Court of Appeals For the Second Circuit Filed April 9, 1956

Before:

MEDINA and HINCKS, *Circuit Judges*,
and BURKE, *District Judge*.

HINCKS, *Circuit Judge*:

These four appeals all involve the validity and infringement of United States Patent No. 2,577,710 which issued to McDonough on December 4, 1951 on an application dated June 16, 1941. The appeals are brought from four decrees of the District Court for the Southern District of New York, in each of which, on a considered opinion reported in 121 F. Supp. 490, it was adjudged that the patent in suit was invalid. The decrees were entered in four suits which had been consolidated for trial and referred to Honorable Simon H. Rifkind as Special Master for report together with his findings of fact and conclusions of law. Two of these suits were actions brought for the infringement of the patent in suit by Sales Affiliates, Inc. against several defendants; the other two were actions for declaratory judgments brought against Sales Affiliates, Inc., seeking a declaration of validity and non-infringement. For purposes of this opinion, we will hereinafter refer to the parties by the terminology used by the Master and the court below, using the designation of "plaintiffs" to refer to the parties collectively attacking the patent and "defendant" to refer to Sales Affiliates, the equitable owner of the patent.

Opinion of Hincks, C. J., Court of Appeals

Although the patent in suit as issued contained 18 claims, all of which were dealt with below, the defendant on brief states: "For the purpose of this appeal, appellant stands on Claims 2, 12, 17 and 18." We take this to be a concession that as to the other claims in suit below, the decree may be affirmed. We shall, therefore, focus our attention on these four claims.

We turn first to consider the scope of the invention claimed. The patent relates generally to a chemical composition suitable for permanent hair waving. The inventor's objective, as stated in the patent specifications, was a composition as effective and as rapid, even when applied without heat, as the sulfides used by the prior art, but free from the bad odor and toxicity characteristic of the sulfides. In his specifications the patentee says "I have discovered that I can obtain these objects [*sic*] by providing as a waving agent a mercaptan or mixture of mercaptans * * * and that an effective waving solution can be obtained by proper formulation including a mercaptan in water." And the specifications further recite discovery (1) that mercaptans become less effective as their molecular weight increases, stating by way of "Example" that a specified mercaptan having a molecular weight of 77 "is far more efficient as a waving agent than cysteine (molecular weight 121)"; (2) that both the polar and non-polar mercaptans function satisfactorily when used in solutions having a concentration of "usually less than 15%"; (3) that they "are especially effective when the pH range is from 7.0 to 10.0, the preferred range being about 9.2"; and (4) that to produce the desired alkalinity, alkaline materials "are particularly effective with less hair destructive effect" if they have "a dissociation constant less than 5×10^{-3} and preferably about 10^{-5}."

The claims relied on all assert a permanent waving composition in which, whether applied with or without heat, a mercaptan is the waving agent and, in each of the four claims all four of the "discoveries" listed serially above are included as limiting factors. Thus in each the mercaptan is limited to one having a molecular weight of "less than 121" and in all four the dissociation constant of the alkaline base is that stated in the specifications to be "particularly effective." The alkalinity of the solution is, respectively, limited to that "ranging from about pH 9.2 to not higher than 9.5" (Claims 2 and 12); to "about pH 9.2" (Claim 17); and to "higher than pH 7 and not higher than pH 9.5" (Claim 18). The concentration of the mercaptan solution is variously stated as "3% to less than about 8%" (Claims 2 and 12); as "1% to about 10%" (Claim 17); and "about 6%" (Claim 18).

In his penetrating analysis of the claimed invention, the Master wrote as follows:

> "It is of course elementary in the patent law that generic claims, such as involved in the present patent, cannot survive where a species within the claimed genus has been invented, known or used by others prior to the patentee's date of invention. 'A generic monopoly must rest upon a generic discovery.' *Metals Recovery Co.* v. *Anaconda Copper Mining Co.*, 31 F. 2d 100, 103 (9th Cir. 1929). Prior invention, disclosure or use of a species anticipates the genus. *In re Steenboch*, 83 F. 2d 912 (C. C. P. A. 1936); *Application of Kyrides*, 159 F. 2d 1019 (C. C. P. A. 1947).
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> "That McDonough was not the first to discover the usefulness of mercaptans as permanent waving agents

or hair softeners is clear beyond peradventure. The U. S. Patent No. 2,201,929, to Speakman, issued May 21, 1940, on an application dated December 9, 1935, specifically disclosed and claimed a method of permanently waving hair in which the waving agent is cysteine hydrochloride, a mercaptan salt, in an alkaline solution of at least pH 10.

"And so here, defendant posits invention not on the broad generic discovery of mercaptan waving lotions, but rather on the discovery that special laws and criteria govern mercaptans in hair waving."

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"In more conventional patent terminology, the invention on which these claims may be said to rest, is the discovery that certain *critical* limits exists for mercaptan waving. Indeed, the law of criticality has been the battlefield upon which much of the present contest has been waged with seemingly irreconcilable views as to the meaning of the term and its applicability to the facts at hand.

"The term 'criticality' as used in the patent sense is not synonymous with invention, but rather, more precisely, is a device for determining the presence or absence of invention. The question always is whether the inventive act is of sufficient magnitude to justify the extension of a legal monopoly for the matter covered by the claims. And in determining whether a patentable invention is present, certain rules have been formulated, among which is that of criticality. Thus, as has frequently been said, the mere location of the optimum conditions of use for a known composition of

matter does not constitute 'invention' so as to entitle the discoverer thereof to a monopoly. That objective, however useful the final result, can be achieved by 'patient experiment', see *Wallace* v. *F. W. Woolworth Co.*, 133 F. 2d 763, 764, cert. denied 320 U. S. 739 (1943); no inventive genius is necessary. Rather, it is only where, other requisites being present, the patentee has found a point or points at which some result differing in kind—and not merely in degree—from the results achieved by the prior art, that an inventive act may be said to exist. At least for this Circuit, the Court of Appeals has summarized the rule in definite terms. In *Kwik Set, Inc.* v. *Welch Grape Juice Co.*, 86 F. 2d 945, 947 (2d Cir. 1936), it said:

> 'A patentee may not arbitrarily select a point in a progressive change and maintain a patent monopoly for all operations in that progressive change falling on one particular side of that arbitrarily selected point. It is only where the selected point corresponds with the physical phenomenon and the patentee has discovered the point at which that physical phenomenon occurs that the maintenance of a patent monopoly is admissible.' ''*

This analysis was accepted by the court below and, except for the applicability of the *Kwik Set* case, has not been questioned by the defendant on this appeal. We, too, accept it not only as a correct statement of the law generally applicable but also as broadly stating the scope of the patent-

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*As the Master noted, the *Kwik Set* case was cited with apparent approval in *Dow Chemical Co.* v. *Halliburton Co.*, 324 U. S. 320, 329.

able subject-matter in a sub-generic discovery such as is here involved.

It was held below that under 35 U. S. C. A. §112 the patent was invalid for lack of disclosure that any one of the four limiting factors listed above was a "critical" limitation. As to this, we hold that a disclosure which teaches that a limitation is critical is enough to satisfy §112 even though the limitation is not expressly stated to be "critical." We think it plain that even to one skilled in the art the reference to a mercaptan *concentration* as "usually less than 15%" would not teach that the limit stated marked a difference in phenomenon. Similarly, nothing in the specifications relating to the molecular weight of the selected mercaptan teaches "less than 121" is a critical limit. Nor, we think, do the specifications teach a *critical range* for the dissociation constant of the alkaline base. So far, we sustain the holding below. But we cannot sustain the holding that the specifications failed to teach that there was anything critical about the pH of the described solution. The specifications speak of a pH range of 7 to 10. They first say that this range is "especially effective" and later refer to it as the "desired range". Then the specifications go on to say:

> "This pH range is particularly critical when the waving agent is used for that type of waving employing a chemical setting agent, as in the so-called 'cold waving' method, since in that system the necessary requirement of speed without hair destruction demands a high concentration of the waving agent in the waving solution. If the pH value is not high enough slow waving action will result and if too high the hair will be

> destroyed or badly damaged. While with sulfite a shorter waving time may require a pH of 10 or above, with these more powerful waving agents, the use of pH's higher than 9.5 must be watched very carefully for with pH of 10 or above, hair destruction or injury may occur before a satisfactory wave is obtained."

We agree that this passage, in saying that if the pH value "is not high enough slow waving action will result" does not teach that pH 7 is a critical low limit of the range: the language used does not import any difference of phenomenon below pH 7 but suggests at most a difference in the degree of the speed of the wave. So far, we agree, there was no disclosure of criticality. But in saying that "if too high the hair will be destroyed or badly damaged" we think the specification does teach that the high limit of the range, pH 10, is critical. It teaches that above that limit the solution will have a different and damaging reaction on the hair. And that teaching, though somewhat weakened, we think not wholly nullified by the subsequent clause in the passage quoted, on which the Master largely relied, saying "hair destruction or injury *may* occur before a satisfactory wave is obtained."

We have then this situation. The patent, as we read it, teaches that a pH ceiling of 10 is a critical limitation: it does *not* teach that a pH floor of 7, or a floor of any pH lower than 10, is a critical limitation. As a result, we hold, the patent, if it survives attacks on its validity on other grounds, is not invalid because of a complete failure to disclose criticality. It discloses an invention comprising all the specified solutions which have a pH characteristic of less than 10.

Criticality in Fact

We turn next to appraise the proofs on which the plaintiffs rely for their contention that none of the limitations disclosed in the patent, including the limitation to a pH 10 ceiling, are in fact critical. That the criticality of pH *10* is the crucial problem is not altered by the fact that the applicant chose to limit his claims to solutions having a lower pH characteristic than 10. For a patentee may so state his claims, which will measure the scope of his monopoly, as to include only a portion of his disclosed invention and abandon the remainder to the public.*

The defendant argues strenuously that the criticality of pH 10 must be tested by the commercial requirements of the tightest curl values without damage in the shortest time. Thus defendant's position is predicated on the premise that criticality may be based solely on commercial superiority. This contention we overrule on the authority of *Kwik Set, Inc.* v. *Welch Grape Juice Co.*, 2 Cir., 86 F. 2d 945, 947, which we now reaffirm. We hold that the applicable standard is one of physical (in this case, of chemical) phenomenon;—that a limitation is critical only if based on physical or chemical fact.**

It was found below that successful hair waving without damage to the hair could be accomplished by the use of mercaptan solutions having an alkalinity in excess of pH 10. That finding was based in part on the result of tests

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* *United Chromium* v. *International Silver Co.*, 2 Cir., 60 F. 2d 913, cert. denied 288 U. S. 600.

** *Libbey-Owens-Ford Glass Co.* v. *Celanese Corp. of America*, 6 Cir., 135 F. 2d 138, 145-6; *David Belais, Inc.* v. *Goldsmith Bros. Smelting & Refining Co.*, 2 Cir., 10 F. 2d 673; *Brady Brass Co.* v. *Ajax Metal Co.*, 3 Cir., 160 Fed. 84.

made by the plaintiffs' expert witness Brown.† These tests, it is true, indicated that solutions below pH 10 effected tighter curls. But we think that fact demonstrates not criticality at any particular degree of alkalinity but only that the optimum range lay somewhere below pH 10. The finding below had further substantial support from the evidence relating to tests made by the defendant which showed (1) a successful wave without hair damage by the use of a mercaptan solution of pH 10.2 and (2) tests resulting in hair damage with mercaptan solutions of pH 9.5 and even at pH 9.2. We hold this finding was supported by adequate evidence properly admitted.

The defendant, however, contends that Brown's tests were not admissible on the issue of criticality. It asserts that commercial practice in hair waving in 1941, when his application was made, was to wave by the "circulation" method and not by the "direct application" method used in Brown's tests. And so, the defendant argues, to test the criticality of McDonough's pH range by the direct application method was erroneously to apply a testing technique which postdated McDonough's invention date. We think the argument is fallacious in law. It is, of course, true that patentable invention must be measured by the advance which it teaches over the prior art. But in determining the existence or non-existence of such physical phenomena as demonstrate a critical advance over the prior art, we think the court is entitled to such aid as derives from any relevant technique,—even one not developed until after the invention at issue.

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† These tests also demonstrated the absence of criticality in the other factors which, under the claims, were imposed on the use of mercaptans.

It is not necessary, however, for us to rest our decision on the ground that the defendant's argument is unsound in law. It also lacks a basis on the facts. For in the field of hair waving, the "direct application" method, even though it may not have been the predominating commercial method in 1941, at least as early as 1940 had had substantial commercial vogue. It was the method of application used in "cold waving" by the so-called "Turban" wave system. It had been used with waving solutions as early as 1934. Its existence was attested in Speakman's Canadian Patent No. 365,290,* issued April 6, 1937 on an application dated December 10, 1935. It also was reflected in Speakman's U. S. Patent No. 2,261,094, issued October 28, 1941 on an application filed December 7, 1935,* which disclosed along with other waving agents the mercaptan cysteine hydrochloride, and definitely taught cold waving by the direct application, as well as the circulation, method.

We are satisfied that the finding made below that the pH 10 ceiling was not critical in fact, was supported by ample evidence. Even more imperatively the proofs required a finding that a limitation to a pH floor of 7—if, contrary to our interpretation of the patent, that limitation had been disclosed as critical—was not in fact critical. Likewise as to other disclosed limitations such as that relating to the molecular weight of the selected mercaptans. At most, all these limitations disclosed some teaching—perhaps useful teaching—as to matters of degree affecting the use and selection of mercaptans in hair waving. But such teaching, we hold, did not rise to the level of patent-

* That Speakman's Canadian Patent was not printed and that his U. S. Patent 2,261,094 did not issue until after McDonough's application date are incidents not affecting their relevance and competence to prove the contemporaneous existence of a commercial practice.

able invention: it did not warrant a private monopoly over the preferred area of the previously disclosed genus of mercaptan hair waving.

The plaintiffs did not confine their attack on the validity of McDonough's claims to the proof of the non-criticality of the limitations stated in the claims. They contended below, and press their contentions on appeal, that the claims in other respects lack patentable invention. These contentions also were sustained, on the Master's recommendation, by the court below. We, too, will consider and rule on those grounds of the decision below. For purposes of our ensuing discussion, we will assume,—contrary to our holdings indicated above—that a pH range of 7 to 10 was both disclosed by the specifications as critical and was in fact critical.

The question of patentable invention depends upon the prior art existing at the invention date of the patent in suit. Consequently, we will preface our discussion of the problem as to invention by an examination of the holding made below that McDonough was not entitled to a pre-application invention date.

McDonough's Invention Date

The defendant contends that McDonough conceived his invention and reduced it to practice long prior to his application date which was June 16, 1941. It points to a memo by McDonough dated September 12, 1935 in which it was noted that "cysteine even at pH 7 will give a satisfactory permanent waving solution." It points to McDonough's contribution to the commercial production of thioglycollic acid in 1940. It stresses tests and experiments made be-

tween 1935 and 1941 with various mercaptan solutions of various pH contents. All the defendant's proofs on this issue we have examined and find wholly without serious challenge to the holding below. Proof that McDonough in 1935 tested cysteine in a pH 7 solution noting a satisfactory result, and that McDonough was a "pioneer" in the mercaptan-hair-waving field, and proof of his experiments in the 1935-1941 period, falls far short of demonstration that prior to his application date McDonough had discovered that the broad genus of mercaptans were suitable for hair waving only in solutions having an alkalinity of less than pH 10. The defendant in its brief asserts that in 1937 McDonough's first cold waving test with thioglycollic acid and ammonia in a pH 8.9 solution having a 6% concentration "was a reduction to practice of the very composition covered by Claims 17 and 18." But proof of a test with a specific waving agent at a specific pH and at a specific percentage of concentration is hardly a reduction to practice of the broad range of waving agents in the broad areas of concentrations and pH's specified in Claims 17 and 18, respectively. Moreover, since the defendant itself argues that the claims are narrower than the disclosed invention, it cannot consistently urge that a test within the limits of the claims constitutes a reduction to practice of the broader invention which it insists is disclosed in the specifications. It is the date of *that* discovery which operates as McDonough's "invention" date,—not the date on which a successful test was made with a single mercaptan solution within the disclosed pH limit. It is asserted that early in 1941 a series of tests had been made in which McDonough reported "pH seems best about 8-9." Certainly that comment was inadequate to show that Mc-

Donough then had in mind pH 10 as a top, critically, limiting factor. Nor does the March 1941 preliminary draft of his patent application definitely indicate that even then his invention had been completed. This document says the mercaptan solutions "are most effective when the pH range is 7.5 to 9.5." It goes on to say that this range "is particularly critical" in cold waving, and that "pH's higher than 9.5 must be watched very carefully and with pH of 10 or above hair destruction * * * occurs." A comparison between the language quoted from this document and that of the application as filed on June 16, 1941, suggests that as late as March 1941, McDonough's conception of his invention was still in process of change. After weighing all the evidence to which the defendant particularly points as supporting a pre-filing date against the evidence summarized by the Master and Judge below which looks the other way, and having in mind that the burden was on the patentee to prove a pre-filing date by clear and convincing evidence, *United Shoe Machinery Corp.* v. *Brooklyn Wood Heel Corp.*, 2 Cir., 77 F. 2d 263, we sustain the finding that the defendant has not proved a pre-filing date of invention.

Lack of Invention

Having found, rightly we hold, that McDonough was not entitled to a pre-filing invention date, the court below held that the McDonough claims lacked patentable invention over Maeder's Australian Patent No. 17990/34, issued on March 7, 1935 on an application dated June 13, 1934; Pye's U. S. Patent No. 2,183,894, issued on December 19, 1939 on an application dated July 26, 1937; the first Speakman U. S. Patent No. 2,201,929, issued May 21, 1940 on an application dated December 6, 1935; the Second Speakman

U. S. Patent No. 2,261,094, issued on October 28, 1941 on an application dated December 9, 1935; Speakman's Canadian Patent No. 365,290, issued on April 6, 1937 on an application dated December 10, 1935; and over the depilatory art including U. S. Patent No. 2,352,524 to Evans and McDonough, issued June 27, 1944 on an application dated June 20, 1938.

We think the defendant is right in its insistence that the Second Speakman patent, which did not issue until after McDonough's filing date, should not be treated as part of the prior art for purposes of determining the issue of patentable invention in McDonough's claims. *Old Town Ribbon & Carbon Co.* v. *Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F. 2d 379; *Comolite Corp.* v. *Davidovicz*, 2 Cir., 111 F. 2d 121; *Stelos Co.* v. *Hosiery Motor-Mend Corp.*, 2 Cir., 72 F. 2d 405. However, even if the court below erred in treating that as a prior art patent, the error is of no moment because Speakman's Canadian Patent No. 365,290, which issued on April 6, 1937 on an application filed December 10, 1935, *was* part of the prior art and just as clearly as Speakman's Second U. S. patent, disclosed in its specifications the use of cysteine hydrochloride as a waving agent in a pH 8 solution, which in reaction to the natural acidity of the hair, might be expected to drop to pH 6; and also that optimum results are obtained when the solution is either pH 6, or 10, or above. The defendant now contends that Speakman's Canadian patent was not a prior art reference because it was typewritten—not printed. That contention we think untenable. *Sirocco Engineering Co.* v. *B. F. Sturtevant Co.*, 2 Cir., 220 F. 137. Cf. *Trico Products Corp.* v. *Delman Corp.*, 8 Cir., 180 F. 2d 529.

We think it rightly held below that in view of Pye it involved no patentable invention over Speakman's first U. S. patent and Speakman's Canadian patent, to "discover" that to prevent hair damage a mercaptan waving agent must be used in a solution having an alkalinity not in excess of pH 10. For Pye had taught that permanent waving is accomplished by a swelling of the hair fibres, "the swelling being proportional to the pH of the solution," and that a solution causing excessive swelling "approaches that of a depilatory." His claims include solutions having a pH range of from 8 to 11. More specifically he taught "that alkali metal sulfides and organic sulfides when adjusted in pH to below 11, will soften the hair * * * without excessive swelling" and that "though the minimum pH, required for stability of most of the solutions of this invention, is between 9 and 9.5, this is entirely a characteristic peculiar to the individual compound used." Whether Pye disclosed the use of mercaptans as waving agents was the subject of conflicting testimony below which was resolved below by a finding in favor of the plaintiffs, with the result that Pye was found to completely anticipate the claims in suit. However, for the impact of Pye on the issue of patentable invention, we will assume that Pye's discovery did not include the use of mercaptans as waving agents but related only to sulfide solutions. Even so, however, we think it was rightly held below that the claims in suit lacked patentable invention over Speakman's first United States patent (which disclosed cysteine hydrochloride as a waving agent) and over his Canadian patent (which disclosed cysteine hydrochloride in a pH 8 solution as the waving agent), in view of Pye who disclosed a sulfide solu-

tion with a pH range of 8 to 11 and taught that hair damage could be avoided by lowering the pH of the solution.*

However, the holding below did not rest solely on the lack of McDonough's advance over Speakman plus Pye. For there was evidence that the permanent waving art and the depilatory art were at least closely analogous if not part and parcel of a single art. Fletcher's French Patent No. 824,804, published February 17, 1938, disclosed a depilatory compound consisting of a mercaptan adjusted to a pH value not lower than 10, thus, like McDonough, teaching that mercaptan solutions at pH 10 and above will cause depilation, or hair damage. A similar disclosure was contained in Bohemen's British Patent No. 484,467, granted April 27, 1938. We conclude, therefore, that even on the assumption—contrary to fact, as we hold,—that McDonough's disclosure of criticality in the use of mercaptans in solutions having a pH range of 7 to 10 disclosed a limitation which was critical in fact, the holding that the claims lacked patentable invention over the prior art disclosures of Pye, the first Speakman patent, and Speakman's Canadian patent derives additional support in the prior art disclosures of the depilatory patents of Fletcher and Bohemen.

Anticipation

The plaintiffs contend, and the court below held, that the patent in suit was anticipated by each of the following references: Speakman's Second U. S. Patent, Speakman's Canadian Patent, the Pye Patent, the Evans and McDon-

* It will be noted that in so holding we have assumed that both limits of McDonough's pH range of 7 to 10 are critical. The holding is even more imperatively required if we are right in our prior holding that neither limit was in fact critical.

ough U. S. Patent No. 2,352,524, issued on June 27, 1944 on an application dated June 20, 1938, the Leavell and Ellis article on colorimetric analysis published in "Industrial and Engineering Chemistry" in 1934, and specific prior uses made by Martin and Grant in 1941. Our ensuing comment on these rulings will still proceed on the assumption that McDonough's application had disclosed that a limitation of mercaptan solutions as to those having a pH range of 7 to 10 was critical and that the limitation was in fact critical.

Both Speakman's Second U. S. Patent and the Evans and McDonough Patent did not go to issue until after the filing date of the patent in suit. On that account they could not be held to constitute part of the prior art or as anticipating patents under 35 U. S. C. A. §102(a). Nevertheless, they were anticipatory under the doctrine of *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U. S. 390, now embodied in 35 U. S. C. A. §102(e). *Old Town Ribbon & Carbon Co.* v. *Columbia R. & C. Mfg. Co., supra; Stelos Co.* v. *Hosiery-Mend Corp., supra.* The defendant does not challenge the findings below that a portion of each of these patents falls within the area of McDonough's alleged invention. It bases its attack on the anticipatory effect of these patents upon its contention that McDonough is entitled to a pre-filing date of invention. That attack falls with our holding, already indicated, to the contrary.

In connection with Speakman, the defendant also contends that the scope of the *Alexander Milburn* doctrine, and of 35 U. S. C. A. §102(e), does not encompass anticipatory material contained in patent *claims* but is restricted to matter disclosed in the *specifications*. That contention

is in direct conflict with the *Alexander Milburn* opinion, as construed by our decision in *Old Town Ribbon and Carbon, supra.* Moreover, as was rightly found below, the anticipatory material in Speakman was not confined to his claims: Speakman in the specifications of his original application disclosed the mercaptan, cysteine hydrochloride, at pH's of 6, 8 and 10 as waving compositiions.

The defendant further contends that the Evans and McDonough patent is not an available anticipatory reference because the application by Evans and McDonough, as joint inventors, was not an application by "another" (i.e., other than McDonough) within the meaning of §102(e).* This contention the court below overruled. That decision, in so far as we have been able to ascertain, is one of first impression in this or any other circuit and, especially in view of the policy considerations involved, we are reluctant to commit this court to that interpretation of §102(e) unless the holding is needed for the disposition of this case. We see no such need. For if we were to hold that the Evans and McDonough patent is a patent of the *same* inventor, we should be constrained to hold that the patent in suit was void for double patenting. *Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186; *Traitel Marble Co.* v. *W. T. Hungerford Brass & Copper Co.*, 2 Cir., 22 F. 2d 259. The Master's acute and accurate reasoning on this problem, which we

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*35 U. S. C. A. 102. *Conditions for patentability; novelty and loss of right to patent.*

"A person shall be entitled to a patent unless—

* * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, * * *"

quote in a footnote,** inescapably leads to that conclusion. With the defendant thus placed between the two horns of a dilemma, there is no need for us now to say which carries the *coup de grace*. One horn or the other is fatal.

Speakman's Canadian Patent which, as we have held, was part of the prior art, reads directly on the patent in suit. This is so even if McDonough's disclosed range limits of pH 7 to 10 were in fact critical since the Canadian Patent discloses solutions of pH 8. Its anticipatory scope is even greater if, as we have held, either of McDonough's pH range limits is not critical in fact. For the Canadian Patent also discloses mercaptan solutions of "about pH 6" (Claim 3), of "about pH 4" (Claim 5) and of "pH 10 or more" (Claim 4). We therefore hold that Speakman's Canadian Patent, as well as his Second United States Patent, anticipates.

** "Plaintiffs also contend that the permanent waving patent is invalid because of double patenting, i.e., issuing two patents for the same invention to the same assignee. While plaintiffs do not press this point vigorously, the Board of Appeals in the Patent Office so held and there is indeed much merit in the argument. Aside from preferences which are expressed in the specifications, the claims of the two patents do overlap and there is definitely a double patenting of compositions falling within the area of overlap. Defendant urges, however, that the compositions specified in the claims of the depilatory patent are necessarily different because the claims call for concentrations of mercaptans sufficient to render the hair removable after contact therewith, whereas none of the compositions falling within the ranges specified in the claims of the permanent waving patent will cause removal of the hair. This is so, it is to be supposed, because the claims of the permanent waving patent require the concentration and pH of the composition to be adjusted so as to obtain 'a permanent change in the configuration of the hair during a given time of application without damage to the hair structure.' But double patenting cannot be avoided simply by defining the compositions in terms of function if in fact the compositions claimed in one are the same as those claimed in the other. Moreover, as the tests in the record show, McDonough's permanent waving compositions, if left on the hair for a sufficient length of time, will depilate. And since the critical factor of time is nowhere defined in McDonough's claims, defendant can derive little comfort from the functional distinction on which it relies."

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We also affirm the holding of anticipation by prior uses by Grant and by Martin, each of whom as early as March 1941 had reduced to practice at least one mercaptan waving solution having a pH falling within McDonough's pH range of 7 to 10.

Whether the disclosures of the Pye patent and of the Leavell and Ellis publication on colorimetric analysis were, each in itself, adequate to constitute anticipations, as was held below, we have considerable doubt. These questions, as well as that of anticipation by Evans and McDonough, we pass since we prefer to place our dispositive rulings as to anticipation on the other references indicated above which seem to us to provide a more solid foundation for our judgment.

Invalidity on Other Grounds

The court below, on the Master's recommendation, overruled the plaintiffs' contention that the claims in suit were void for inoperativeness and for the inclusion of new matter not included in the applicant's disclosure. Those rulings we affirm on the opinion below.

The court below also ruled that the claims were void for indefiniteness. This ruling we also affirm. We will, however, somewhat amplify the reasoning relied on below by the following observations. The range limits of concentration and of pH stated in the claims, notwithstanding the lack of precision with which the limits were stated, were distinctly narrower than the critical limits of the invention which the defendant claims to have disclosed in the specifications. As we have already observed in connection with our discussion of criticality, the applicant if he wished was

entitled to claim a monopoly narrower in scope than that of his full disclosure and thereby abandon to the public so much of his invention as lay outside his stated claims. That is what the defendant insists was done. However, because this was done the requirement of the Act for definiteness in the statement of claims must be strictly construed. In the ordinary case, in which the intended scope of the claims is commensurate with the scope of the disclosure, any peripheral uncertainty as to the claims can be clarified by reference to the application. Not so, however, when the claims are concededly narrower than the disclosure, as here. Confronted with claims such as these, a member of the public is left at his peril to guess just where the applicant has drawn the line between his claimed monopoly and the public domain. We think the facts that the applicant himself and the defendant's expert witness were in disagreement as to the meaning of the limits of the claims as stated, and that there were several commercial compositions falling within the peripheral area of uncertainty, were significant.

Especially in the light of this consideration, we think the holding of indefiniteness is required.* Claim 18 may be thought to be the narrowest and most definitely stated of all the claims. Let it be granted that the limitation in Claim 18 to a "solution having a pH higher than pH 7 and not higher than pH 9.5" is sufficiently definite. But what is meant by the concentration limit of "about 6%"? Having in mind that the specifications do not teach, and the defendant does not claim, that there is anything critical

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* *Standard Oil Co. of California* v. *Tide Water Associated Oil Co.*, 3 Cir., 154 F. 2d 579, 581-6; *Libbey-Owens-Ford Glass Co.* v. *Celanese Corp. of America*, 6 Cir., 135 F. 2d 138, 144-5. Cf. *Dow Chemical Co.* v. *Halliburton Co.*, 324 U. S. 320, 329.

about a 6% concentration, does this mean that compositions which in other respects would infringe Claim 18 are abandoned to the public if their concentration is somewhat above or below 6%? If so, why did not the applicant state 6% without the qualifying word "about"? The very use of the qualification imports that the limitation suggests some *range* of concentration. But nothing in the four corners of the patent defines that range. And the holding of indefiniteness even more conclusively applies to the other claims in all of which (2, 12 and 17) both the pH range limits and the concentration range limits are stated with similar ambiguity. We do not, of course, go so far as to hold generally that claims defining range limitations with some degree of approximation are in all cases fatally indefinite. Our holding here relates to limitations on claims which are narrower than the invention disclosed in the specifications and which purport to assert a private monopoly of compositions falling within a known chemical genus.

In affirming the holding of indefiniteness, we think it unnecessary to rule upon the impact of the so-called adjustment clause which is contained in these claims or the conflicting positions of the parties as to whether the claims now before us fell within the scope of the Master's conclusions as to the effect of the adjustment clause. Even were these problems resolved in accordance with the defendant's contentions, we should adhere to our holding that the claims are fatally indefinite.

Being abundantly satisfied that the claims in suit are invalid for lack of criticality and invention, for anticipation, and for indefiniteness, we shall not discuss or rule upon the findings of infringement made below.

DEFENDANT'S COUNTERCLAIM AGAINST HELENE CURTIS

Also referred to the Master and dealt with by him and the court below was the defendant's counterclaim against Helene Curtis, one of the plaintiffs herein. On this counterclaim the defendant sought recovery of large damages claimed to have been caused by the act of Helene Curtis, through its agent, Grant, by filing on April 4, 1948 in the Patent Office, while the defendant's McDonough application was pending therein, a "protest" against the grant of a patent thereon containing deliberate and malicious misrepresentations of fact tending to show that the McDonough application was not patentable. The counterclaim further alleged that, because of this protest, on June 16, 1948 the Examiner "withdrew his previous allowance of claims in said application, reversing his holding of patentability of subject-matter therein without citing any new prior art or new grounds for rejection, and finally rejecting all claims therein which covered any composition or method then or now being made, used or sold by Defendant or by Plaintiff." Because of this malicious or intentional conduct on the part of Helene Curtis, the defendant in its counterclaim further alleges that the defendant was "put to extraordinary delay and expense in the further prosecution of said patent application, including exceedingly expensive and prolonged research to develop technical data and evidence to refute the position taken by said Examiner on and after June 16, 1948" and including unsuccessful prosecution of an appeal to the Board of Appeals of the Patent Office and prosecution to final judgment in favor of the defendant of a §4915 suit. This delay in the issuance of its

patent, it was alleged, in addition to the expense of research and litigation, caused the "loss of royalties and other damages."*

The court below found that the defendant had failed to prove that the protest, which concededly Helene Curtis filed through Grant, contained actionable misrepresentations of fact or that it was the cause of damage to the defendant. Since our study of the voluminous record satisfies us that there was inadequate proof of any causal connection between the plaintiff's protest and the defendant's alleged damages, we affirm that finding and shall not extend our discussion beyond that issue.

Prior to the filing of this protest, there was nothing in the record to show that the application had been either formally allowed or informally indicated as allowable. On the contrary, after the application had been twice rejected the applicant had on August 3, 1945 submitted a proposed amendment and affidavits, and on August 13, 1945 filed an appeal to the Board of Appeals. On June 14, 1946, the Examiner mailed to the applicant a notice of advisory action on the proposed amendment of August 3, 1945 indicating no change in his conclusion that the application was unpatentable. Thereafter, on September 10, 1946, apparently for purposes of the appeal and in alleged response to the advisory action of June 14, 1946, the applicant filed an

* The defendant also filed a counterclaim against the Gillette Company. However, as the Master noted, this counterclaim was wholly unsupported by evidence and on his recommendation it was dismissed by the court below with the comment that "it was abandoned in fact, if not formally." This ruling has not been raised as a ground of appeal. It is of interest only for the side-light which it throws on the tactics of the defendant who complains that Helene Curtis caused it additional expense in prosecuting its application in the Patent Office and yet put Gillette to the expense of preparing a defense to a counterclaim which it supported by no evidence whatever.

amendment wherein he canceled all claims and substituted Claims 68 to 88, inclusive, with 105 pages (as measured in the File Wrapper) of additional affidavits and supporting argument. On February 12, 1947, the Examiner notified the applicant by letter that his Claim 88 was in interference with Claim 40 in a co-pending application of one Martin and that his "claims 68 through 87 will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to the applicant." On June 16, 1947, applicant moved to dissolve the declared interference on the ground that the interference count (which was identical with his own Claim 88) was "unpatentable for the reason that it is vague and indefinite" and not supported by the applicant's disclosure. In response to this motion, on December 9, 1947, the Examiner dissolved the interference "*pro forma* as to the original count on interference" but, stating that "there is undoubtedly a common invention involved," suggested a new count in interference, designated as "Count E." On December 17, 1947, applicant moved that the Examiner strike from his ruling of December 9, 1947 "his suggestion of a new count based on common inventive subject-matter in the two interfering applications and his comment that an issue of priority thereon is considered 'essential'." This motion the Examiner denied on December 30, 1947. After an unsuccessful motion to the Primary Examiner for a dissolution of the interference, the applicant on February 7, 1948 addressed a petition to the Commissioner to direct the Primary Examiner to strike Count E suggested as being in interference with Martin's application. All this, it will be observed, occurred prior to Grant's "protest."

Thereafter, under date of June 16, 1948, the Commissioner referred the applicant's prior petition to the Exam-

iner "with discretion to consider anew his suggestion of the count proposed by him." The Examiner then in response to applicant's motion of February 7, 1948 withdrew his proposed Count E "as being unpatentable for lack of invention" and dissolved the interference. On June 16, 1948, the Examiner mailed to the applicant a response to his amendment of September 10, 1946. In this action, Claim 88 was rejected, as well as other specified claims, "as being drawn to non-elected species"; all claims were stated to stand rejected "as being unduly multiplied," as had been indicated in prior Office actions; and also consistent with prior Office action all other claims were rejected as lacking invention over specified references except Claim 82 which was held to be amendable.

The defendant by brief asserts that the proofs show that prior to Grant's protest the "examiner had withdrawn his rejection of McDonough claims and had held the subject-matter of the application to be patentable." We find in the record no evidence whatever to support this assertion. Certainly it is directly contrary to all Office actions, as appears from the foregoing resume of the file wrapper. It is true that in his remarks appended to his Amendment of September 7, 1948, the defendant's counsel asserted that its prior amendment of September 10, 1946, "was entered after interviews on September 5 and 6, 1946, at which time the Honorable Examiner stated informally that he considered the claims to be allowable." But we find no support for this self-serving assertion either in the pretrial depositions of the Examiners which are in evidence or elsewhere in the record. And the Board of Appeals in its opinion on a petition preliminary to the hearing of the defendant's appeal on the merits said: "The allegations of

appellant that all of the claims in the case were allowable and the case put in condition for issue by the entry of the amendment of September 10, 1946, are without basis in fact. The record unequivocally shows that all the claims were never allowed. Appellants' assertions to the contrary are without weight." They are without weight with us also.

The defendant further seeks to buttress his assertion that prior to the protest the claims had been found to be in an allowable state by arguing that the interference with Martin declared on February 12, 1948, and the subsequent motions and rulings thereon, necessarily so imported: absent allowable claims there would have been no occasion for interference proceedings,—so the argument runs. But certainly the fact that Claim 88 was thought to be in interference carried not the slightest implication that the Examiner considered all the other, non-interfering, claims to be allowable.

Even if the Examiner, when he declared the interference with Claim 88, had considered that claim to include patentable matter we see not the slightest ground for inference that his subsequent action as to Claim 88, any more than his subsequent action on the other claims, had been affected by Grant's protest. The defendant in its motion to dissolve the interference had conceded that Claim 88 was unpatentable for its vagueness: the Examiner rejected it on the ground that it was drawn to an unelected species,—a ground of rejection which had been applied in earlier Office actions. We think it preposterous to urge that the defendant's subsequent labor and research activities were caused by the rejection of a claim which it conceded to be unpatentable for vagueness. It even is

equally untenable to urge that a rejection which was officially predicated on the ground of non-elected species was caused by the alleged misrepresentations in the protest. For the protest was not relevant to the ground of "unelected species." Furthermore, the Board of Appeals in its opinion of May 2, 1949 on the merits noted that claim 88, and certain other claims, "have been rejected as not inclusive of the elected subject-matter. Since that *rejection has not been challenged*, we need not further consider these claims." (Emphasis supplied.) Thereafter, Claim 88 was not put in issue in the §4915 suit and was not included in the patent as issued. The defendant's acquiescence, thus indicated, in the official disposition of Claim 88 is in basic conflict with its assertion that its subsequent labor and expense was an effort to undo harm caused by the protest.

We find nothing in the pretrial depositions of the Examiners or in their Office actions and rulings to warrant even a suspicion that they were affected by the protest. Their Office actions were in all respects expressly predicated on other references. We conclude that the expense and damages for which the defendant seeks recovery on this counterclaim were incidental to a persistent and vigorous prosecution of an extraordinarily complex application and not at all caused by Grant's protest. The conclusion makes it unnecessary to consider whether an action lies to recover damages for wrongful interference with the prosecution of an application for a patent which, after issue, is held to be invalid. Whatever may be the correct answer to that question, on the ground above discussed we hold that the record in this case warrants—indeed requires, an affirmance of the dismissal of this counterclaim.

Validity of Procedure Below

The defendant also presses on appeal a claim of error based on its contention that it was deprived of a fair trial in that it was denied an opportunity to argue orally on the merits before the Master. At the close of evidence, the Master inquired whether counsel wished to submit their arguments on brief or to have an oral argument as well. Counsel expressed preference for oral argument and it was agreed that if there was to be an argument it should be held after the briefs were in. The Master throughout the discussion indicated that he had no preference in the matter and was willing to adopt whatever procedure would suit counsel's convenience. Upon learning of counsel's preference the Master stated: "Very well, then the disposition will be that after the briefs are in, unless counsel change their minds, there will be a day set for argument." The final disposition of the matter as stated by defendant's counsel was: "I suppose the time for oral argument would be something we would agree upon later with the Master," to which the Master replied: "I should rather think so. I think to fix a date for argument beyond the 15th of June (the date reply briefs were to be submitted) is an attempt to foresee the future beyond our capacity."

The main briefs were exchanged on April 30th. Thereafter, a meeting was held on May 14, 1953 at which the Master and opposing counsel were present. As to the understanding reached at this conference on the subject of oral argument there are conflicting recollections. The following facts, however, are undisputed. (a) In the preliminary negotiations between opposing counsel arranging for the May 14 meeting counsel for the defendant suggested

that they "ascertain, at that time, whether he [the Master] will want oral arguments and try to arrange a tentative date for that." (b) At the meeting, the Master stated that after he had studied the briefs and the record (at that time the reply briefs had not yet been exchanged) he would advise counsel if he, the Master, wanted oral argument on any matter but that this should not preclude counsel from making argument generally or on any points they might wish to discuss. (c) No request for oral argument was made thereafter. (d) The reply briefs were exchanged on June 15, 1953. (e) The Master filed his report on January 13, 1954 without prior communication with the parties. (f) Thereafter defendant's counsel did not assert its desire for oral argument to the Master by petition for reconsideration although he was in communication with the Master as to other matters pertaining to the case. To these undisputed facts defendant's counsel adds his recollection that it was his "*understanding* that, prior to rendering his final written report, the Master would inform counsel whether or not he wished oral argument and that after being so informed it would then be appropriate for either party to request argument if desired" and that he "*indicated* that I would *probably desire* to make an argument for defendant whether the Master or plaintiffs requested same or not."

Considering the importance which the defendant now attaches to the lack of oral argument, we find it difficult to comprehend how counsel would have relied on an "understanding" and an "indication of probable desire" for a period of eight months as a basis for protection of its right to oral argument. The defendant submitted a total of 456 printed pages of briefs before the Master and never after

the May 14 meeting gave any indication by formal request or otherwise that it was demanding an oral argument. Nor does it now assert that it was denied an opportunity to present to the Master any arguments not contained in its briefs.

Moreover, in addition to failing to request an oral argument by petition for reconsideration before the Master, defendant's counsel omitted to argue the point either orally or by brief before the District Court.

Taking into consideration all of the foregoing factors and the admonition of the Supreme Court to decide the necessity of oral argument as a requirement of procedural due process on a case-to-case basis, *Federal Communications Commission* v. *WJR*, 337 U. S. 265, 274-277, we hold that the defendant has been accorded all the requirements of a fair and proper trial.

Denial of Defendant's Motion for New Trial

After the appeals herein had been docketed, the defendant obtained permission of this court to file below a motion for a new trial on the ground of newly discovered evidence. This motion was denied below and that ruling is now before us on appeal.

The evidence on which the defendant based its motion was a patent application Serial No. 222,527, filed April 23, 1951 in the United States Patent Office by A. E. Brown, the patent on which issued to the plaintiff Gillette, as assignee, on September 14, 1954. Until that date application Serial No. 222,527 was not available to the defendant's inspection in the United States Patent Office. However, a certified copy of said application had been filed in the Patent Office of the Union of South Africa in support of an identical

application for a patent which Gillette, as Brown's assignee, had filed in that office on March 31, 1952, upon which a patent was granted to Gillette as such assignee by the Union of South Africa on October 20, 1952. The Official Journal of Patents of South Africa of April 9, 1952 and November 5, 1952 showed, respectively, the filing of the application and the granting of the patent thereon (No. 14869) to Gillette as Brown's assignee and that the subject-matter was "Improvements in or Relating to Hair Waving Compositions." These issues of the South African Journal of Patents were received in the United States Patent Office on June 4, 1952 and December 8, 1952, respectively. We have no reason to question the assertion of the defendant's counsel that this South African application did not come to his attention until December 1954. But from an uncontradicted affidavit of the plaintiff it appears that the evidence on which the new trial was sought was a patent application the existence, ownership and subject-matter of which a counterpart had been published to the world, and notice whereof had been on file in the United States Patent Office before the presentation of evidence to the Master in the case below had been concluded.*

Brown, the applicant of U. S. Serial No. 222,527, had testified as an expert witness for the plaintiffs in the trial below. The new trial was sought to afford defendant an opportunity to impeach the testimony which he there gave and also to show an alleged and wrongful suppression of

* The Australian Official Journal of Patents of May 8, 1952, received in the United States Patent Office on August 28, 1952, gave notice that a corresponding patent application had been filed in the Australian Patent Office on April 22, 1952 by Brown and Gillette as assignee for a hair waving composition, and the Australian Journal of June 29, 1952, which was received in the United States Patent Office on August 1, 1952, disclosed that the complete application had been laid open to public inspection.

evidence by Brown and by a Gillette executive, one Reed, who had testified in a pretrial deposition.

In its motion addressed to this court for permission to file its motion for a new trial, the defendant refers to numerous extracts from Brown's application which were thought to be inconsistent with Brown's testimony on trial. But a careful study of the plaintiffs' memorandum and affidavits in opposition make it clear that many of the claimed inconsistencies are due to the defendant's use of incomplete extracts or to meanings inconsistent with the context. As a result most of the alleged inconsistencies disappear like snow under a March sun. Even the defendant in its reply shifts its position as to most of these claimed inconsistencies: instead of persistence in a contention that passages in Brown's application were necessarily inconsistent with Brown's testimony below it repeatedly asks in various forms, "What tests were performed to ascertain the truthfulness of this statement?" in the Brown application, thereby insinuating that such tests, if they had been put in evidence might have been helpful to the defendant's case on the merits. Of course, after the evidence had closed and judgment had been entered, the defendant was not at liberty to embark on a fresh fishing expedition in the hope that evidence of tests made in connection with Brown's application might disclose information tending to support its position as to the patent in suit.

For such an effort there was no basis in the pretrial examination of Mr. Reed who, the defendant charges, by his testimony intentionally suppressed evidence as to tests which Gillette had made. The defendant's charge of "untruthful testimony" and "wilful suppression" of evidence, as made in his motion to remand, was based on Reed's nega-

tive answer to a question by defendant's counsel as to whether he had made experiments in his work "*specifically directed* at determining the criticality of pH with cold waving solutions, mercaptans." That answer we find wholly consistent with Brown's No. 222,527 application which was predicated not at all on the criticality of any pH range or indeed on the criticality of any of the factors involved in the patent in suit. The defendant, in its reply memorandum, charged that to give Reed's answer what we find to be its plain meaning (which the transcript shows the Master to have fully understood) was "to indulge in semantic quibbling." This charge is conclusively disposed of by Reed's testimony immediately preceding the extracts which the defendant quoted, wherein the witness made it abundantly clear that over a period of time, in a belief based on broad research exploring pH ranges with various mercaptans, he had come to the conclusion that there was "nothing in the pH value of 10 in thioglycolate solutions for cold hair waving" and being of that conclusion had "never conducted a series of experiments exclusively aimed at the answer to that question." Thus the witness had not suppressed, but rather, proclaimed the existence of prior research work and there is nothing to show that the defendant ever demanded to see or that the plaintiffs refused to produce, any records made of such research. If there has been any semantic quibbling connected with the charge of suppression it can only be that defendant's counsel was the author.

The defendant, in its reply to plaintiffs' affidavits in opposition, did, however, persist in claiming that the following paragraph from Brown's application is inconsistent with Brown's testilmony and the plaintiffs' position in the trial.

"My invention is particularly striking in its effects as demonstrated in relation to the thiol cysteine. This compound, used in concentrations and at pH values which are both safe and commercially feasible, does not provide an acceptable wave; indeed, at room temperature it shows so little waving activity that for all practical purposes it is valueless for home waving. Upon the addition of a few mols of urea, however, the composition becomes substantially as effective as the conventional ammonium thioglycolate compositions."

This is the most plausible and, for its impact on the merits, the most serious claim of inconsistency upon which the defendant bases its motion for a new trial. But Brown's testimony in the trial, which the defendant now seeks to impeach, was directed to the issue of criticality. And defendant's contention that the materials in Brown's application constituted impeachment of his testimony and admissions against the plaintiff Gillette rests on his further contention that criticality may be measured by commercial superiority. Having rejected that contention we find no irreconcilability between Brown's testimony at the trial and his application for the patent in question.

Moreover, we think the surface suggestion of inconsistency largely evaporates in the light of Brown's answering affidavit in which he points out that he was there speaking of the *safety* and the *commercial feasibility* of cysteine and its *practicability* for cold waving in the home. He alleges in his affidavit, without contradiction, that cysteine is a vastly more expensive ingredient than other mercaptans and also than urea. That it was a weaker reducing agent than other mercaptans and, consequently, was correspond-

ingly effective only in higher concentrations was in line with his evidence at the trial. Also at the trial he had testified to the toxic effect on the scalp of highly alkaline solutions,—an effect independent of hair damage from solutions of excessive pH content. We think it obvious that especially for home waving an inexpensive solution is a factor making for commercial success. In the light of these considerations, we do not think that his testimony on trial would be seriously impugned by the statement in his application which, as we confidently interpret it, went no further than to say that a cysteine solution of a pH low enough to be safe from toxic effects on the scalp and of a concentration high enough to give a satisfactory cold wave under home conditions would be too expensive for commercial success,—a difficulty which could be mitigated by his proposed addition of urea to the solution.

We cannot believe that the inclusion of such tenuous "impeaching" material in the record on the merits would have changed the ultimate conclusions of the Master or the Judge below. Especially is this so since their conclusion of "invalidity" was based also on grounds other than lack of criticality to which alone this desired impeachment seems to be relevant. And we can with even greater confidence say that the inclusion of Brown's application and patent in the basic record if the case were reopened to permit its receipt into the evidence would not, in view of all the proofs, affect our ultimate holding on the merits. We conclude, therefore, that in denying the motion for a new trial, there was no error. The matter was concededly within the discretion of the trial judge. Certainly no abuse of discretion was shown. Indeed, we think that on the merits of the motion his discretion was wisely exercised.

We will add—although the conclusion just stated is not dependent on this additional observation—that we think the motion was not seasonably made in view of the facts recited above relating to Brown's South African application and patent and the notices contained in the South African Journal of Patents. In one aspect, it is indeed harsh to charge the defendant with lack of diligence for its failure earlier to discover the allegedly impeaching material of this patent and its underlying application. But absence of knowledge by an inventor of the existence of an earlier patent will not save him from its anticipatory effect; and when a defendant, charged with infringement, is preparing his defense he must make his search for anticipatory patents in season to present them at trial. To relieve either the inventor or the infringer of these requirements would vastly add to the already great uncertainty as to the validity of outstanding patents: it would open the door to patent litigation on an interminable piecemeal basis. The same results will follow if after trial an infringer whose defense of invalidity has been overruled is given opportunity to reopen the case for the presentation of after discovered anticipations or if after trial a patentee whose patent has been adjudged invalid can reopen his case to present after discovered patents for material thought either to support his own position or to destroy or weaken his adversaries' position.

The closest question involved in defendant's motion to obtain a new trial, in our opinion, is raised by the plaintiffs' request that we impose upon defendant plaintiffs' costs and counsel fees incurred in defense of the motion. We agree with plaintiffs' counsel that the charges of false testimony and wilful suppression of evidence were serious

and wholly unsupported by the showing made, and that most of the claims of inconsistencies were without substance. They were inexcusable in the sense that they were wholly unnecessary to the effective presentation of such merit as the motion could reasonably be thought, even by a partisan advocate, to have. Nevertheless, we cannot say that there was no ground for making the motion: we think it not unreasonable that the defendant should have thought that the paragraph quoted above from Brown's application might have some impeaching effect on his testimony. On the whole, we think the request to tax plaintiffs' counsel's fees against the defendant should be denied. Their printing costs will, of course, be taxed in their favor in the usual course.

Affirmed.

"What Part Does Oral Argument Play in the Conduct of an Appeal"—*

Honorable JOHN M. HARLAN
41 Cornell Law Quarterly 6, Fall 1955

* * * "I do not mean to suggest that briefs do not play an important part in the appellate process. They do, of course, particularly when the litigation is a complicated one. But I think that the lawyer who depreciates the oral argument as an effective instrument of appellate advocacy, and stakes all on his brief, is making a great mistake. There are several reasons for this.

First of all, judges have different work habits. There are some judges who listen better than they read and who are more receptive to the spoken than the written word.

Secondly, the first impressions that a judge gets of a case are very tenacious. They frequently persist in the conference room. And those impressions are actually gained from the oral argument, if it is an effective job. While I was on the Court of Appeals, I kept a sort of informed scoreboard of the cases in which I sat so as to match up the initial reactions which I had to the cases after the close of the oral argument with the final reaction that I had when it came time to vote at the conferences on the decision of those cases. I was astonished to find during the year I sat on that Court how frequently—in fact, more times than not—the views which I had formed after the more careful study of the briefs which, under our system in the Second Circuit, came in the period between the closing of the arguments and the voting at the conference.

*An address before the Judicial Conference of the Fourth Circuit at Ashville, N. C., June 24, 1955.

Thirdly, the decisional process in many courts places a special burden on the oral argument. I am giving away no secrets, I am sure, when I say that in one of the Courts of Appeals when I was assigned to sit temporarily the voting on the cases took place each day following the close of the arguments. In the Supreme Court, our practice, as is well known, has been to hold our conferences at the end of each week of arguments. They have been on Saturdays up until now, but under a more enlightened schedule they will be on Fridays next term, because beginning October we are going to sit four days a week. Under either of those systems you can see the importance which the oral argument assumes.

Fourth, and to me this is one of the most important things, the job of courts is not merely one of an umpire in disputes between litigants. Their job is to search out the truth, both on the facts and the law, and that is ultimately the job of lawyers, too. And in that joint effort, the oral argument gives an opportunity for interchange between court and counsel which the briefs do not give. For my part, there is no substitute, even within the time limits afforded by the busy calendars of modern appellate courts, for the Socratic method of procedure in getting at the real heart of an issue and in finding out where the truth lies." * * *

"The Oral Argument on Appeal"—

HAROLD R. MEDINA

Amer. Bar Ass'n. Journal—Vol. XX—March 1934—No. 3, pp. 139, 140.

• • • "If the appeal is to be presented in as clear, convincing and attractive manner as possible, argument should supplement the brief, no matter how good a printed brief may have been submitted on the appellant's behalf. The judges are human beings and not mere machines. If their sympathy or their interest is aroused, as they should be by a proper oral argument on behalf of the appellant the effect is bound to be of advantage." • • •

35USC §22. **Printing of papers filed**

The Commissioner may require papers filed in the Patent Office to be printed or typewritten. (R. S. 488; 35 U. S. C., 1946 ed., 12.)

35USC §102. **Conditions for patentability; novelty and loss of right to patent**

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

• • •

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

* * *

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. (R. S. 4886, 4887, 4923; 35 U. S. C., 1946 ed., 31, 32, 72.)

35 USC §135. **Interferences**

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which

the patent was granted. (R. S. 4904, 4903; 35 U. S. C., 1946 ed., 52, 51.)

SEC. 4886, R.S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 *Stat.* 1212:

SEC. 2. This Act [amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*] shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however*, That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4887. R.S. (U. S. C., title 35, sec. 32) No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and six months in cases of designs, prior to the filing of the application in this country in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country, which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, printed after R. S. Sec. 4886, *ante*.]

Federal Rules of Civil Procedure

Rule 53—Masters

* * *

(e) Report.

(1) *Contents and Filing.* The master shall prepare a report upon the matters submitted to him by the order of reference and, if required to make findings of fact and conclusions of law, he shall set them forth in the report. He shall file the report with the clerk of the court and in an action to be tried without a jury, unless otherwise directed by the order of reference, shall file with it a transcript of the proceedings and of the evidence and the original exhibits. The clerk shall forthwith mail to all parties notice of the filing.

(2) *In Non-Jury Actions.* In an action to be tried without a jury the court shall accept the master's findings of fact unless clearly erroneous. Within 10 days after being served with notice of the filing of the report any party may serve written objections thereto upon the other parties. Application to the court for action upon the report and upon objections thereto shall be by motion and upon notice as prescribed in Rule 6 (d). The court after hearing may adopt the report or may modify it or may reject it in whole or in part or may receive further evidence or may recommit it with instructions.

* * *

(5) *Draft Report.* Before filing his report a master may submit a draft thereof to counsel for all parties for the purpose of receiving their suggestions.

Interferences: Definition, Preparation, Declaration

37 Code of Federal Regulations

§ 1.201 Definition, when declared

(a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent or for reissue of different parties when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of the regulations in this part.

• • •

§ 1.291 Protests to the grant of a patent

The patent statutes do not provide for opposition to the grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

SEP 7 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1956

No. 333

SALES AFFILIATES, INC.,
Petitioner,

vs.

HELENE CURTIS INDUSTRIES, INC., ET AL.,
Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

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New York, N. Y.
September 7, 1956

ABBREVIATIONS AND RECORD REFERENCES

Abbreviation	For
Respondents	Helene Curtis Industries Inc. Helene Curtis Sales, Inc. C. V. Layden, d.b.a. Southwestern Beauty Products Company The Gillette Company Walgreen Drug Company of Texas Skillern & Sons, Inc.
Petitioner	Sales Affiliates, Inc.
PA	Respondents' Appendix to brief before Court of Appeals
DA	Petitioner's Appendix to brief before Court of Appeals, Volumes I to V incl.
DA E	Exhibits in Petitioner's Appendix to brief before Court of Appeals, Volumes VI to VIII incl.
MR	Master's Report printed in DA Vol. V, pp. 2952-3086 incl.
O	Opinion of District Court printed in DA Vol. V, pp. 3228-3266 incl.
CA	Opinion of Court of Appeals printed in Appendix to the Petition, pp. 1a-38a.

All emphasis ours unless otherwise indicated.

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IN THE

Supreme Court of the United States

October Term, 1956

SALES AFFILIATES, INC., *Petitioner,* *vs.* HELENE CURTIS INDUSTRIES, INC., *et al.*, *Respondents.*	No. 333

RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

The petition presents no special or important reason why the writ should be granted. There is no conflict between the decisions of any Courts of Appeals. There is no Federal question which has been decided in a way in conflict with any decision of this Court. And there has been no departure from the accepted and usual course of judicial proceedings. These are straightforward patent suits in which the Master, the District Court and the unanimous Court of Appeals for the Second Circuit concurred in holding the patent in suit invalid, and in dismissing all of petitioner's counterclaims. The suits were rightly decided and there is no sound reason why this Court should grant the writ.

OPINIONS BELOW

The Master's Report (MR 2952-3086) is not reported. The opinion of the District Court (O 3228-66) is reported in 121 F. Supp. 490. The opinion of the Court of Appeals for the Second Circuit (Appendix to Petition, pp. 1a-38a) is reported in 233 F. 2d 148 (denial of petition for rehearing not reported).

STATEMENT

Petitioner's statement of the case is incomplete, inaccurate, and at many points directly at variance with the concurrent findings of fact below.

For example, the petition reiterates as fact extravagant assertions that "the remarkable performance achievements [of McDonough's] invention made cold permanent waving a practical and useful art" (Pet. p. 25; also at pp. 8-9, 23, 33, 35)—"The entire industry of 'home waving' . . . is based precisely thereon" (Pet. p. 8). The same extravagant, unfounded claims were asserted before the Master, the District Court, and the Court of Appeals, and were flatly rejected in twice-affirmed findings of fact. The facts are:

—" 'That McDonough was not the first to discover the usefulness of mercaptans as permanent waving agents or hair softeners is clear beyond peradventure' " (CA 3a-4a).

—"Actually, despite the fact that McDonough now claims to have known everything there was to know about mercaptan cold waving in 1938, Sales Affiliates [the patent owner] was left far behind in the competitive struggle" (MR 2992 fn) ". . . undoubtedly because, as shown by this record, others than McDonough . . . were earlier in developing satisfactory cold wave lotions" (MR 3027).

—"For defendant now to lay claim to a vast industry whose success was achieved independently of any contribution made by its patentee, would constitute a perversion of the beneficent objectives underlying our patent system" (MR 3027).

The foregoing is but one of many conflicts between the facts as found and the facts as stated in the petition. That the case presented by the petition is a very different case

from that decided below is apparent from the Master's Report and the opinions of the District and Appeals Courts.

The patent in suit has been held invalid by concurring decisions of three able and experienced tribunals: former Judge Rifkind as Special Master, Judge Irving R. Kaufman in the District Court, and Judges Medina, Hincks and Burke in the Court of Appeals.

The Master found that the evidence of invalidity of the patent in suit was "overwhelming" (MR 3030). The District Court was "convinced that as to the patent in suit the evidence overwhelmingly supports the Master's conclusion" (O 3266). The Court of Appeals was "abundantly satisfied that the claims in suit are invalid" (CA 22a).

All three tribunals concurred in finding that the patent was invalid on each of the following nine grounds:

—(1) because the alleged invention—the discovery of so-called critical limits governing mercaptan hair waving—was non-existent in fact;[1]

—for lack of invention over (2) the prior teachings of the first U. S. Speakman, the Canadian Speakman and the U. S. Pye patents in the hair waving art,[2] and (3) the prior teachings of the Fletcher and Bohemen patents in the depilatory art;[3]

—because the patent was anticipated by (4) the second U. S. Speakman patent,[4] (5) the Canadian Speakman patent[5] and the prior developments of (6) Grant and (7) Martin;[6-7]

—(8) alternatively for anticipation by or double patenting over the Evans and McDonough U. S. depilatory patent;[8]

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[1]MR 2977-84; O 3235-8; CA 8a-11a.

[2]MR 2965, 2994-3004, 3008-9, 3013; O 3239-43, 3245; CA 13a-16a.

[3]MR 3004-10, 3013; O 3243; CA 16a.

[4]MR 2997, 2999-3004, 3013, 3067-8; O 3240-3; CA 16a-19a.

[5]MR 2997, 2999-3004, 3013; O 3240-3; CA 16a-19a.

[6-7]MR 3006-8, 3021-4, 3026-7; O 3245-7; CA 20a.

[8]MR 3007-8, 3010-3; O 3243; CA 16a-19a.

—and (9) because each of the claims is fatally indefinite.[9]

In affirming the judgments below the Court of Appeals likewise affirmed the concurrent findings of the Master and District Court that the patent was invalid on three additional grounds as to which petitioner asserted no error in its appellate briefs and which are therefore not discussed in the appellate opinion, namely for lack of invention (10) over the Maeder patent in the hair waving art[10] and (11) over the teachings of Vago and of Turley and Windus in the depilatory art;[11] as well as (12) for lack of invention in view of the contemporary developments by others.[12]

In addition the District Court and the Court of Appeals concurred in holding that petitioner was accorded all the requirements of a fair and proper trial;[13] and all three tribunals concurred in rejecting petitioner's counterclaim against Helene Curtis.[14]

QUESTIONS PRESENTED

The petition nowhere questions the affirmed findings that the patent is invalid on five of the twelve grounds enumerated above, namely—for anticipation by the second U. S. Speakman patent (Ground 4); for lack of invention over the teachings of Maeder in the hair waving art (Ground 10), and of Fletcher, Bohemen, Vago and Turley and Windus in the depilatory art (Grounds 3, 11); and for lack of invention in view of the contemporary developments by others (Ground 12). Thus, whether or not petitioner could succeed in reversing all the findings con-

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[9]MR 3031-40, 3077-82; O 3248-9; CA 20a-22a.
[10]MR 2993-4, 3005-6, 3008, 3013; O 3240-1, 3243.
[11]MR 3005-6, 3009-10, 3013; O 3243.
[12]MR 3021-7; O 3245-6.
[13]CA 29a-31a; O 3232; Petitioner's first "Question Presented".
[14]CA 23a-28a; O 3252-7; MR 3052-9; Petitioner's Questions 8 and 9.

cerning the invalidity of the patent which are challenged in its "Questions Presented" (Pet. pp. 3-4, Qs 2-7), the patent would still remain invalid on these unchallenged grounds.

ARGUMENT

Question 1:

The petition states that the Court of Appeals and the District Court erred in rejecting petitioner's contention that it was "denied due process of law in violation of the Fifth Amendment to the U. S. Constitution by being deprived of oral summation . . .".

1. No such question is involved. Petitioner was not "deprived of oral summation." It had every opportunity for argument at every stage of the case. The reason there was no further argument before the Master after the briefs were submitted was that petitioner either did not want it or was negligent[15] in failing for eight months to give "any indication by formal request or otherwise that it was demanding an oral argument" (CA 31a).

2. In order to make this contention at all petitioner finds it necessary to reiterate as "undisputed fact" that further oral argument "had been demanded by petitioner and promised by the Master before submitting his final report (p. 29a)" (Pet. p. 15; also at pp. 10, 13-4, 18, 21-2). This is directly contrary to the facts as found by the Dis-

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[15] ". . . The victim of alleged prejudice cannot be allowed to nurse it along to the point of reversibility and then take advantage of a situation which by his silence he has helped to create." *United States* v. *5 Cases*, etc., 179 F. 2d 519, 523 (2 Cir. 1950), cert. denied 339 U. S. 963 (1950). Cf. *Townsend* v. *Jemison*, 48 U. S. (7 How.) 706, 718-9 (1848): ". . . looking to the defendant's own neglect as the cause, a party cannot be allowed to take advantage of his own wrong or inattention. Thus, it has been decided that a writ of error will not lie for one's own neglect or irregularity."

trict Court in a sentence omitted[16] from the quotation which petitioner represents as summarizing the District Court holding (Pet. p. 14).

At the "meeting . . . at which agreement was reached between all parties" (O 3232 fn) the Master stated that so far as he was concerned, he would not require counsel to argue the case generally but would advise counsel if he desired argument on any particular matter. The Master further stated that he would be entirely agreeable to having the case argued if counsel for any of the parties later desired it. As the District Court found, counsel indicated their full agreement with this arrangement and no request for oral argument was made thereafter (O 3232 fn; DA 3217-22).

3. As the Court of Appeals observed, petitioner considered this objection so insubstantial that its "counsel omitted to argue the point either orally or by brief before the District Court"[17] (CA 31a). Petitioner's own acknowledgment of the "insubstantial" nature of this objection is further shown by its petition for rehearing, which contained not a word of dissent from the Court of Appeals' careful review of the procedure below or its holding that petitioner "has been accorded all the requirements of a fair and proper trial" (CA 31a).

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[16]The findings of the District Court (with the omitted portion italicized) were:

> "*Section B was directed toward the Master's failure to set a day for argument following the submission of briefs. This objection, however, overlooked a meeting on May 14, 1953, at which agreement was reached between all parties on this point. Furthermore, such an objection seems* insubstantial in view of the extensive arguments that have been heard." (O 3232 fn).

[17]Nevertheless the District Court gave the matter meticulous consideration. After petitioner had fully argued and briefed the case before the District Court without mentioning the point, the District Judge requested petitioner to state its position on this objection which petitioner had thus ignored (DA 3217-22; O 3232 fn), and thereupon reached the conclusion quoted in footnote 16.

Question 2:

Petitioner's Question 2 contends that this Court's action is necessary to settle what it calls "the direct conflict between the Second Circuit holding below that the patent in suit is invalid and the holding of validity by the District Court for the District of Columbia which ordered the U. S. Patent Office to issue the patent . . ." (Pet. p. 22).

1. As its first point under Question 2 petitioner asserts —"With one exception (Canadian Speakman patent . . .) the prior art patents and publications ruled upon adversely to petitioner by the courts below were found by Judge Letts [of the 4915 court] not to anticipate or invalidate the invention" (Pet. p. 23).

This is grossly misleading.

In addition to the Canadian Speakman patent, the "second" Speakman U. S. patent (Ground 4, *supra*, p. 3), which the Master and the District and Appeals Courts found was a statutory bar to patentability, was not relied on by the Patent Office in the 4915 court (Pl. Ex. P 78, Finding 14; DA 435, 948). While the 4915 findings prepared by petitioner's counsel mentioned the second Speakman U. S. patent, as the Master found[18] this reference was not before the 4915 court.

Moreover the prior art relied on in the 4915 suit did not include five additional patents and publications over which the patent in suit was held invalid for lack of invention—namely the Maeder Australian patent (Ground 10, *supra*, p. 4); the Fletcher and Bohemen patents (Ground 3, *supra*, p. 3); and the articles of Vago and Turley and Windus (Ground 11, *supra*, p. 4).

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[18]"Next we come to the three Speakman patents. *Only the first of these,* U. S. No. 2,201,929, bearing an issue date of May 21, 1940, *was a reference before the Patent Office and the District Court in the 4915 suit. The second Speakman U. S. Patent,* No. 2,261,094, although originally cited by the Patent Office, *was withdrawn* in view of McDonough's oath that he had established completion of his alleged invention, in so far as Speakman disclosed it, prior to Speakman's filing date of December 9, 1935" (MR 2997).

In addition to these misstatements about the 4915 court's findings on the prior art patents and publications, the petition is far from frank in omitting all reference to the fact that there was no evidence before the 4915 court of the contemporaneous developments of other workers in the hair waving art. The proofs of these other developments provided the basis for three additional grounds of patent invalidity which were not considered by the 4915 court, namely, anticipation by the prior developments of Grant and Martin (Grounds 6 and 7, *supra*, p. 3), and lack of invention in view of "the contemporary progress in the art at the time the claimed invention was achieved" (O 3245-6; Ground 12, *supra*, p. 4).

Thus the Second Circuit adjudication of invalidity rests on eight separate grounds which were not even considered by the 4915 court. Petitioner's Question 2 does not arise because the asserted "direct conflict" between holdings on the issue of validity simply does not exist.

2. Petitioner asserts that the supposed conflict between the Second Circuit and 4915 decisions creates uncertainty in Patent Office administration and the industry because "The findings of fact and conclusions of law [in the 4915 suit] are binding on the Patent Office and govern the administration thereof as to the patent in suit and a series of related patents" (Pet. p. 10).

The law as stated by this Court in *Hoover Co.* v. *Coe* 325 U. S. 79, 89 (1945) is to the contrary.[19]

In these circumstances it is the clear duty of the Patent Office to follow the later Court of Appeals decision.

3. As to the findings on which the Second Circuit adjudication of invalidity rests, the District Court observed:

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[19] ". . . where an applicant has succeeded in a bill filed under R. S. 4915, the courts have not questioned the power of the Patent Office subsequently to disallow the claims for want of invention over a newly discovered reference to the prior art" (325 U. S. at p. 89).

> "The Master, a former Federal Judge, was eminently qualified to deal with a case of such complexity. The length of his report and the detailed and meticulous consideration of each point presented show the extraordinary thoroughness with which he dealt with a complex problem" (O 3230).

The Master's consideration of every point included a review of the findings which were prepared by petitioner's counsel in the *ex parte* 4915 suit,[20] and the rejection of those findings in the light of the many additional facts and defenses which were fully developed in the adversary proceedings below.

4. Petitioner's contention of "conflict"[21] would expand this Court's supervisory jurisdiction far beyond that contemplated by Rule 19(b) to embrace review of every patent whose issuance is obtained by a 4915 suit where the patent is later held invalid in adversary proceedings. But even a direct conflict of decisions by a Court of Appeals and a District Court on a point of Federal law—a conflict which does not exist here—is not a basis for certiorari.[22] The important considerations underlying the limitations on the

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[20]The 4915 case was decided from the bench in a two-sentence opinion (Pet. pp. 22-3).

[21]Even petitioner concedes that its asserted "conflict in decisions here referred to is not the classic case of conflict between two Circuit Courts of Appeal upon the same patent" (Pet., p. 25).

[22]"The Supreme Court will not grant certiorari to review a decision of a federal court of appeals merely because it is in direct conflict on a point of federal law with a decision rendered by a district court, whether in the same circuit or in another circuit. The Court tries only to achieve uniformity in federal matters among the various courts whose decisions are otherwise final in the absence of Supreme Court review" (Stern and Gressman, *Supreme Court Practice*, Second Edition, 1954, p. 116).

"Maintaining consistency within the circuits is the task of the Courts of Appeals, which were established for the express purpose of relieving the Supreme Court of supervision over the decisions of the District Courts. Accordingly a conflict between decisions of the Courts of Appeals and decisions of District Courts in other circuits is entirely outside the rule which moves the Supreme Court to grant the writ solely on the ground of a conflict of decisions" (Robertson and Kirkham, *Jurisdiction of the Supreme Court of the United States*, Wolfson and Kurland Edition, 1951, § 325, p. 637).

jurisdiction of this Court are *a fortiori* applicable here where (1) the alleged conflicting decision is merely a quasi-administrative district court decree authorizing the Patent Office to issue a patent in a proceeding in which the Commissioner was the only defendant,[23] and (2) issuance of the patent in suit was not obtained by the 4915 decree, but through a settlement negotiated with the Patent Office, by which the Commissioner's appeal from the 4915 court's order was dismissed and all the claims which had been before the 4915 court were substantially modified (MR 2957).

Question 3:

While not disputing the fact that the specification of the Canadian Speakman patent discloses anticipating subject matter,[24] petitioner contends that the patent cannot anticipate because the subject matter is not claimed. This contention is based on misstatements of fact and of law.

1. Petitioner misrepresents the court below as holding that the anticipating subject matter disclosed in the Speakman specification is not covered by Speakman's claims.

The purported basis for this assertion is not only specious on its face[25] but also it ignores other portions of the opinion which show that the Court of Appeals considered the claims as well as the specification in holding that "Speakman's

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[23]Compare, *Rosenberg* v. *Groov-Pin Corporation*, 81 F. 2d 46, 47-8 (2 Cir. 1936); opinion by Judge Learned Hand.

[24]As the Master found, "Its [Canadian Speakman's] disclosures are almost identical in all respects with those contained in the second Speakman U. S. Patent" (MR 2997). Petitioner asserts no error here in the concurrent findings of all three tribunals that the second U. S. Speakman patent is a complete anticipation of the alleged invention of the patent in suit (*supra*, p. 4).

[25]Petitioner's reasoning is that:

"The Court of Appeals held that the Canadian patent 'disclosed in its *specifications* the use of' the alleged anticipating subject matter (p. 14a). It is therefore clear that the subject matter alleged to anticipate was disclosed only in the typewritten specifications" (Pet. p. 29; petitioner's emphasis).

Canadian Patent . . . *reads* directly on the patent in suit" (CA 19a).

Many of the Speakman claims (1, 2, 6, 7, 10-12; Pl. Ex. P151 at DAE 170-2; DA 1243, 2829) are broad enough to include the anticipating subject matter mentioned by the Court of Appeals—"the use of cysteine hydrochloride as a waving agent in a pH 8 solution" (CA 14a).

None of the authorities cited by petitioner suggests that the claims of a foreign patent must specifically recite every detail of the disclosure before the disclosure can be considered "patented" within the meaning of 35 U. S. C. § 102(b). Such a doctrine would impose an absurd restriction on the statute.

2. The alleged conflict in the interpretation of "patented" as used in 35 U. S. C. § 102(b) does not exist. The *Leeds*[26] and *Alexander*[27] cases are not in point; both cases deal with the interpretation of R. S. 4887 [predecessor of present 35 U. S. C. § 102(d)] and not with R. S. 4886, the predecessor of present § 102(b). Quite different policy considerations govern the use of the word "patented" in the two sections. All the other cases relied on by petitioner were concerned with the special status of German Gebrauchsmuster.[28]

The law is well settled to the contrary of petitioner's contentions in the Sixth[29] as well as the Second[30] and other Circuits.[31]

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[26]*Leeds & Catlin* v. *Victor Talking Mach. Co.*, 213 U. S. 301 (1909).

[27]*General Electric Co.* v. *Alexander*, 280 Fed. 852 (2 Cir. 1922).

[28]As petitioner's authorities point out, Gebrauchsmuster are not patents, *Permutit Co.* v. *Wadham et al.*, 15 F. 2d 20, 21 (6 Cir. 1926); and only their claims, not their specifications, are published, *Permutit Co. v. Graver Corporation*, 43 F. 2d 898, 902 (7 Cir. 1930).

[29]*Allied Wheel Products* v. *Rude*, 206 F. 2d 752, 759-60 (6 Cir. 1953).

[30]*Hoddersen-Balling* v. *Lorenz*, 60 F. 2d 709, 710 (2 Cir. 1932); *Sirocco Engineering Co.* v. *B. F. Sturtevant Co.*, 220 Fed. 137, 143 (2 Cir. 1914), cert. denied 238 U. S. 636 (1914); *United States Bung Manuf'g Co.* v. *Independent Bung & Bushing Co.*, 31 Fed. 76, 79-80 (C. C. S. D. N. Y. 1887).

[31]*Trico Products Corp.* v. *Delman Corp.*, 180 F. 2d 529, 533 (8 Cir. 1950); *In re Dann*, 47 F. 2d 356 (C. C. P. A. 1931).

3. The Court of Appeals quite properly rejected as "untenable" (CA 14a) petitioner's contention that Speakman's Canadian patent was not a prior art reference under Sec. 102(b) because it was typewritten—not printed. Contrary to petitioner's argument (Pet. pp. 29-31) this holding is fully supported by the *Sirocco*[32] case decided by the Second Circuit in 1914.

Question 4:

Petitioner attacks the law of "criticality" as stated by the Second Circuit in *Kwik Set*[33] and the decision below, and represents these decisions as conflicting with a rule that a "composition [may be] patentable if it displays inventive results over the prior art" (Pet. p. 3).

Petitioner's argument misstates the holdings below. No conflict exists, and the question presented does not arise.

The Court of Appeals,[34] as well as the Master[35] and the District Court[36] all pointed out that in passing on the issues of lack of invention and anticipation they were assuming—contrary to fact—that petitioner had met the requirements of the *Kwik Set* case and had established that the pH range 7 to 10 was critical in fact.

In the face of the comprehensive, detailed analyses of the prior art references vis-a-vis McDonough's alleged invention, in the Master's Report[37] and the opinions of both the District[38] and Appeals Courts,[39] it is absurd to urge that

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[32]*Sirocco Engineering Co.* v. *B. F. Sturtevant Co., supra*, fn. 30.

[33]*Kwik Set* v. *Welch Grape Juice Co.*, 86 F. 2d 945 (2 Cir. 1936). The Court of Appeals observed: "As the Master noted, the *Kwik Set* case was cited with apparent approval in *Dow Chemical Co.* v. *Halliburton Co.*, 324 U. S. 320, 329" (CA 5a fn).

[34]CA 11a, 16a, 16a fn, 17a; e.g. "For purposes of our ensuing discussion, we will assume,—contrary to our holdings indicated above—that a pH range of 7 to 10 was both disclosed by the specifications as critical and was in fact critical" (CA 11a).

[35]MR 3002.

[36]O 3231, first footnote, and O 3240-2.

[37]MR 2993-3013, 3021-7.

[38]O 3239-43, 3245-7.

[39]CA 13a-20a.

"The Court of Appeals has set forth as law a reprehensible rule requiring a comparison of the results of the patented compositions with each other instead of against the results of the prior art" (Pet. p. 11).

All the tribunals below made it unmistakably clear that in evaluating McDonough's alleged criticality invention they were comparing the results of the patented compositions with the results of the prior art.[40] Thus measuring McDonough's results against the results of the prior art, the affirmed findings show that McDonough's alleged contribution was non-existent.

Question 5:

The question presented by petitioner is—

> "Can genus claims be invalidated by use or knowledge of a species by another prior to completion of the invention of the genus but after the invention of the same species by the patentee?"

1. No such question arises.

Petitioner asserts no error in the concurrent findings of fact by all the tribunals below[41] that petitioner had not proved any invention date for the so-called generic invention of the patent in suit prior to McDonough's filing date, June 16, 1941.

Petitioner erroneously states that "The undisputed facts of record show . . . and the Court of Appeals recognized"

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[40]". . . it is only where, other requisites being present, the patentee has found a point or points at which some result differing in kind—and not merely in degree—from the *results achieved by the prior art*, that an inventive act may be said to exist" (CA 5a, MR 2966).

". . . It is true that criticality is determined by whether the limits claimed produce a difference in kind from results achieved by the *prior* art, 35 U. S. C. § 103. Thus, criticality should be determined here by whether McDonough's limits produced a new result in 1941.

"I conclude that the Master's conclusions as to criticality should be sustained" (O 3236; original emphasis).

[41]CA 12a-13a; O 3232-9, 3246-7; MR 2984-93.

that McDonough had made the thioglycolic acid species invention "long before any knowledge or use of such species by the others" (Pet. p. 38).

Quite the contrary. All the tribunals below found that McDonough was not the first but the last.[42] The findings show that as early as March 1941 both Grant and Martin had reduced the thioglycolic acid species to practice with successful waving lotions (CA 20a; O 3245-7; MR 3022-7); and "it is evident that McDonough in fact did not have a satisfactory mercaptan waving lotion at this time" (MR 2990). As the Master and District Court found—

> "Moreover, it must be remembered that McDonough—for all of his experimentation—arrived at the conclusion that thioglycolic acid, now the only mercaptan used in permanent waving—was not as satisfactory for waving as glyceryl monomercaptan, which has practically disappeared from commercial use. Sales Affiliates, as I have already noted, was left behind in the competitive struggle, undoubtedly because, as shown by this record, others than McDonough—notably Grant and Martin—were earlier in developing satisfactory cold wave lotions" (MR 3027).

Furthermore, in the case of Grant both the Master and the District Court also held " 'that the evidence is convincing' . . . that Grant arrived at the *generic* invention before McDonough".[43]

2. Even on the erroneous statement of facts in the petition, the patent statutes and the decisions of this Court require an affirmative answer to petitioner's Question 5.

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[42]". . . of all of the people working in the field of mercaptan waving . . . it took McDonough longer to conceive and to develop a satisfactory waving lotion than anyone else" (O 3245; MR 3026).

[43]O 3246; MR 3024.

The unchallenged findings below show that both Martin and Grant had developed and put into extensive use successful thioglycolic acid waving lotions before McDonough's "inventive concept was . . . born" (MR 2990). Nor is it disputed that these lotions were substantially identical with lotions which are now charged to infringe the patent in suit.

To permit McDonough to monopolize these previously "known" and "used" compositions by patenting them as falling within alleged critical limits would violate the plain language of the patent statute, 35 U. S. C. § 102(a), as well as its basic objectives. And it would contravene the principle long established by the decisions of this Court—"That which infringes if later, anticipates if earlier." *Miller* v. *Eagle*, 151 U. S. 186, 203 (1894).

Question 6:

Petitioner's sixth question is—

> "Can there be double patenting between the claims of a patent limited to hair waving without damage over the claims of a depilatory patent limited to hair destruction?"

All three tribunals found that "there is a substantial overlapping if not a close identity in the disclosures" (O 3243)—and that "the claims of the two patents do overlap and there is definitely a double patenting of compositions falling within the area of overlap" (CA 19a fn).

The contention that the very same compositions can be patented twice simply by including functional statements as to the purpose, result or effect of use is unsound on its face and contrary to the decisions of this Court.

Miller v. *Eagle* does not hold as petitioner states (Pet. p. 43). The patent in that case was held invalid for double

patenting, and the decision clearly supports the holding of the courts below.[44]

Petitioner misrepresents the District Court's decision as "holding that the entity 'Evans and McDonough' is not 'another' than McDonough under § 102(e)" (Pet. p. 43). What the District Court held was that McDonough could not "avoid the Depilatory Patent by arguing that he is not 'another' within the meaning of 35 U. S. C. A. § 102(e)" —and that the finding of anticipation was "clearly correct" (O 3243).

Moreover, petitioner's Question 6 represents but one of the "horns of the dilemma," either of which the courts below found fatal (CA 19a). Petitioner's contention (Pet. p. 43) that "the other horn," anticipation under § 102(e), can be avoided by carrying McDonough's invention date back of the filing date of the depilatory patent is foreclosed by the twice-affirmed findings that the petitioner has not proved any invention date prior to the June 1941 filing date of the hair waving patent.[45]

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[44]"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ . . .

". . . it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent. *It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent.*"

* * * * *

"*. . . It is not the result, effect, or purpose to be accomplished which constitutes invention, or entitles a party to a patent,* but the mechanical means or instrumentalities by which the object sought is to be attained . . ." *Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, 198, 201 (1894).

[45]CA 12a-13a; O 3232-9, 3246-7; MR 2984-93; e.g., Petitioner asserts that the "record is clear that McDonough had completed far more of his permanent waving invention than may be disclosed in the depilatory patent, long before the filing date thereof" (Pet. p. 43). The Master found that the record establishes just the opposite:

"Defendant also urges that the overlapping features of the depilatory patent were not discovered until after McDonough had reduced

Question 7:

Petitioner's Question 7 poses a fictitious issue designed to conceal its effort to overturn the twice-affirmed findings of fact underlying the holding of indefiniteness.

The portions omitted by petitioner in quoting the Court of Appeals' decision on indefiniteness make it clear that in the excerpts quoted by petitioner the Court of Appeals was pointing out the special need for clarity in claims which are asserted to cover less than the invention described where there is nothing whatever in the specification to guide the public as to their metes and bounds.

It is plain from the full text of the decision (CA 20a-22a), portions of which are reproduced below[46], that the Appeals Court was merely applying the fundamental principle stated by the Master—"It is axiomatic that patent claims must be stated with such precision and particularity as to leave no doubt as to the precise scope of the monopoly which is claimed" (MR 3031). Where even petitioner's expert witness and the inventor "could not agree on the meaning of many of the limits stated . . . how possibly can the producers of commercial products, some of which infringe under one interpretation of the claims, and do not

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his permanent waving invention to practice. But, as has already been noted, defendant has not shown any permanent waving invention prior to the date of the depilatory patent" (MR 3012).

[46]". . . The range limits of concentration and of pH stated in the claims, notwithstanding the lack of precision with which the limits were stated, were distinctly narrower than the critical limits of the invention which the defendant claims to have disclosed in the specifications. . . . Confronted with claims such as these, a member of the public is left at his peril to guess just where the applicant has drawn the line between his claimed monopoly and the public domain. We think the facts that the applicant himself and the defendant's expert witness were in disagreement as to the meaning of the limits of the claims as stated, and that there were several commercial compositions falling within the peripheral area of uncertainty, were significant.

"Especially in the light of this consideration, we think the holding of indefiniteness is required" [Citing cases] (CA 20a-21a).

infringe under another interpretation, know when they run afoul of McDonough's patent. This is the very type of ambiguity condemned by the patent statute" (O 3248-9).

Summary as to Questions 8 & 9.

These questions relate solely to a collateral counterclaim against respondent Helene Curtis based on its filing in the Patent Office of a protest against the issuance of petitioner's patent. They have no bearing on the decisions below holding that patent invalid. The protest was properly filed in accordance with the rules of the United States Patent Office (Pet. p. 46a). The Master and the District Court found that the protest did not contain any misrepresentations, and the Court of Appeals affirmed the holdings of the Master and the District Court that there was no causal relationship between the protest and any delay in the issuance of the patent. These matters do not pose any special or important question meriting the consideration of this Court. All three tribunals below held that the counterclaim should be dismissed (CA 23a-28a; O 3252-7; MR 3052-9).

Question 8:

The Court of Appeals did not ignore the Patent Office rule requiring a determination of patentable subject matter before declaring an interference nor did it hold that there was no evidence of such a determination. On the contrary the Court assumed that the Examiner had found claim 88 allowable, as petitioner admits.[47]

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[47]". . . the Court of Appeals held . . . (2) Only claim 88 (count in interference) was considered allowable" (Pet. p. 53).

The Court said:

> "Even if the Examiner, when he declared the interference with Claim 88, had considered that claim to include patentable matter we see not the slightest ground for inference that his subsequent action as to Claim 88, any more than his subsequent action on the other claims, had been affected by Grant's protest. The defendant in its motion to dissolve the interference had conceded that Claim 88 was unpatentable for its vagueness . . ." (CA 27a).

Question 9:

This question also presents no reason why the writ should be granted.

(a) It was not "a false premise," as asserted in the petition, that the Patent Office had neither formally allowed the patent application nor indicated that it was formally allowable. At most, the Patent Office, in declaring the interference, held that claim 88 was allowable. But petitioner itself asserted that that claim was not patentable.[48] As to this the Court of Appeals said:

> "On June 16, 1947, applicant moved to dissolve the declared interference on the ground that the interference count (which was identical with his own claim 88) was 'unpatentable . . .'" (CA 25a).

Again in December 1947 and in January and February 1948 petitioner sought to escape from the interference (CA 25a, PA 613-616), all prior to the filing of the Helene Curtis protest on April 4, 1948.

A comparison of claim 88 (the count of the interference, PA 610) with the claims in suit shows that the latter are quite different. No claim such as claim 88 was before the 4915 court.

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[48]Even taking for granted the proposition that patentability must have been found by the Examiner when an interference was declared, the Master held that:

> ". . . the ultimate fact necessary to sustain defendant's cause of action, that Helene Curtis' actions were responsible for delaying the issuance of the patent, is not supported by the evidence . . . it is more likely that the delay of which defendant complains was occasioned by its own action in conceding unpatentability of the claim in interference" (MR 3054-5).

The District Court held that the Master's conclusions were amply supported by the evidence (O 3253), and held:

> "Certainly defendant did not prove that Helene Curtis' action was the cause of the rejection of McDonough's claims, or at the very least more likely the cause than McDonough's own action" (O 3255).

(b) and (c) All petitioner's assertions that the protest contained misrepresentations are merely repetitive of charges which the Master in explicit findings flatly rejected as unfounded in fact (MR 3055). The District Judge not only held this finding of the Master to be correct but himself reviewed the evidence and reached the same conclusion (O 3255).

CONCLUSION

The petition for writ of certiorari fails to show any reason which should move this Court to review the carefully considered concurrent decisions of the three tribunals below.

The petition is without merit and should be denied.

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September 7, 1956

OCT 1 1956
JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

October Term, 1956

No. 333

SALES AFFILIATES, INC.,

Petitioner,

vs.

HELENE CURTIS INDUSTRIES, INC., HELENE CURTIS SALES, INC., THE GILLETTE COMPANY, *et al.*,

Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

The answering brief of plaintiffs-respondents consists essentially of an attempt to make out the petition as nothing but a series of grossly misleading statements contrary to the facts of the case. These are serious charges, and as we show, would be far more appropriately directed to respondents' brief than to the petition.

We give below short categorical replies to glaring errors and misstatements in respondents' brief, indicating the pages on which the points appear. These, and the petition itself, are dispositive of all of the contentions appearing therein.

Statement

R. Br. Page 2:

The first quotation of the so-called "facts" merely refers to Speakman's paper patent disclosure of cysteine hydrochloride, as the very next sentence in the Court of Appeals opinion shows (4a). There is no evidence whatsoever that cysteine hydrochloride has been commercially used, and the fact is that it has not been.

Respondent's second quotation—neither the Court of Appeals nor the District Court accepted the Master's origination of an erroneous "competitive struggle" or commercially "satisfactory" lotion criteria to show that McDonough's discoveries and teachings were not followed by the industry. The Court of Appeals itself referred to the proofs as showing McDonough to be a "pioneer" in the mercaptan-waving field (12a).

The last sentence from the Master's report quoted by respondents likewise was never affirmed by either court below and is totally erroneous, as shown by the Master's own statements from other portions of his report cited on pages 7 and 8 of our Petition.

R. Br. Page 3:

The alleged nine grounds of invalidity are nothing more than three grounds* each subdivided into fragments by respondents and newly labeled as separate "grounds".

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*(1) Lack of novelty or invention over the prior art, (2) double patenting and (3) indefiniteness.

R. Br. Page 4:

So-called grounds 10, 11 and 12 were fully raised and urged as error in the Court of Appeals. See our Court of Appeals briefs, portions of which are reprinted here as an appendix:

Ground 10: Maeder—See appendix pages 2r and 5r.

11. Vago, Turley and Windus in the depilatory art—The District Court lumped all the depilatory art references together and never mentioned these three publications (D.A. 3243). We similarly treated the depilatory art as a whole before the Court of Appeals and, in any event, our argument of invention over *all* of the prior art because of criticality obviously disposed of these three references. See appendix pages 1r and 5r.

12. Contemporary development— See appendix pages 3r and 4r re Grant and Martin. Willat and Reed were mentioned by neither court below.

Questions Presented (R. Br. 4)

Ground 4, see Petition page 31-38.

Ground 10, Petition pages 31-38.

Grounds 3, 11—Petition pages 31-38.

Ground 12—The Court of Appeals did not affirm the Master's remarks on "contemporary" development. In any event, our Petition on pages 38-40 asserts that McDonough's work was at least five years prior to the alleged "contemporaneous" developments.

Question 1

R. Br. Page 5:

1. Respondents merely supply an *ipse dixit* to the ridiculous effect that Petitioner never "wanted" oral summation although petitioner had made an unqualified request for same at the close of the trial. See D.A. 2937-2939. For "negligence" see petition pp. 13-16.

In both of the two cases cited by respondents, *waiver* was held because the litigant failed to make request at any time for its rights and failed to object at any time to denial of its rights. Neither case involves a request for a constitutional right made *twice* with filing of objection immediately upon denial of the right. How can these facts in the case at bar constitute waiver?

2. That request for oral summation was made by petitioner and promised by the Master (as stated in our Petition) is undisputedly shown by the proceedings before the Master at D.A. 2937-2939. With regard to the May meeting, the Court of Appeals found as an "undisputed fact" (29a) that—"at the meeting, the Master stated that after he had studied the briefs and records (at that time the reply briefs had not been filed) **he would advise counsel**, if he, the Master, wanted oral argument on any matter, but that this should not preclude counsel from making argument generally or on any point they might wish to discuss" (30a). The facts found by the District Court are a mere broad recitation which is in no wise inconsistent therewith.

R. Br. Page 6:

3. Any fair reading of the Court of Appeals' opinion on denial of our right of oral summation will show it to be all encompassing and final in so far as that Court was concerned. A petition for rehearing on the point would have been surplusage and an annoying inconvenience to that Court.

Question 2

R. Br. Page 7:

Respondents ignore the fact that the file wrapper of all the proceedings in the Patent Office, and the art therein, was before Judge Letts. In finding 15, Judge Letts disposed of all the art (D.A. E1586).

The Maeder British patent, which is substantially identical with the Maeder Australian patent, was definitely before Judge Letts in the District of Columbia. See D.A. E1585-6. Similarly, Turley and Windus was before Judge Letts in the District of Columbia. See D.A. E1585-6. Vago adds nothing as to mercaptan solutions and their effects on hair not contained in Turley and Windus. Neither were referred to by the District Court or the Court of Appeals below.

The Fletcher and Bohemen foreign depilatory patents are much less detailed than the U. S. Evans and McDonough depilatory patent which antedated them* and which was relied upon as the best depilatory art by both tribunals below (14a, 18a, D.A. 3243).

Respondents cite no support whatsoever for their statement that the second Speakman U. S. patent was not before the 4915 Court. Although it had been withdrawn as a *reference* during the Patent Office prosecution, the largely identical first Speakman patent was always before the Patent Office and both of the patents were before Judge Letts (D.A. E1585-6).

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* *Sales Affiliates* v. *Hutzler*, 164 F. 2d 260 (C. A. 4th).

R. Br. Page 8:

The Grant use had been brought to the attention of the Patent Office forcefully by the iniquitous Helene Curtis protest (Petition page 49). The Martin use certainly was known to the Patent Office which had declared an interference between McDonough and Martin (Petition page 49). The eight separate grounds allegedly not considered by the 4915 court are again algebraic manipulations by respondents couched to avoid the obviously direct conflict between the Judge Letts' findings and decision with the evidence and decisions below.

R. Br. Page 8:

The *Hoover* v. *Coe* case is bottomed upon the existence of a newly discovered reference to the prior art which adds something as a matter of substance. As we have shown in the petition, there was no prior art of substance present in the Second Circuit proceedings not covered in the District of Columbia proceedings.

R. Br. Page 9:

3. Beyond attempts to distinguish the prior art references in the 4915 proceeding, the Master never once referred to Judge Letts' decision or findings, nor did the District Court or the Court of Appeals. Initial drafting of the findings by counsel, subject to objections of petitioner's adversary (the Patent Office), with review and changes by the court before signature is accepted judicial practice. Respondents' innuendoes are a slur on the lower courts.

R. Br. Page 9:

4. Petitioner has never urged that certiorari jurisdiction should be exercised here on the basis of one circumstance or factor. Viewing the instant case as a whole, petitioner has contended instead that the patent in suit is

vital to an extremely large nation-wide industry. The interests affected by the conflict here between the Second Circuit and the District of Columbia overshadows the relative unimportance of the average conflict between decisions of two different circuit courts of appeals over the usual patent.

Question 3

R. Br. 10:

1. "reads" obviously does not mean the same thing as "claims". The claims cited by the Court of Appeals and the respondents do not refer to any pH between 7 and 10 and none of the Courts below so held.

R. Br. 11-12:

The lower courts have long ago settled that "patented" means precisely the same thing in both R. S. 4886 and R. S. 4887. See *Queens* v. *Friedlander,* 149 Fed. 175 and *Permutit* v. *Wadham,* 15 F. 2d 20, 21. The decisions in the petition show the German Gebrauchsmuster to be utility *patents.* The Speakman Canadian patent is even less of a patent, using respondents' criterion, since *nothing* therein was a printed publication. That is the whole point. See Petition page 30 for discussion of the Respondents' cases.

Question 4

R. Br. 12:

Save for the Master's historical references to the 48 hour Turbanwave and to Willat's toxic sulfide (D.A. 2960), there is not a word in the Master's report, District Court opinion or Court of Appeals opinion referring to actual *results* obtained with the prior art compositions, and respondents have cited none. The quotations at the

bottom of R. Br. 13 show that the courts below gave lip service to the general criticality rule; but, they then superimposed thereon the truncated sentence, extracted from Judge Manton's opinion in the *Kwik-Set* case, requiring instead that McDonough's results be compared with McDonough's results.

Question 5

R. Br. 13-14:

The Court of Appeals never affirmed the Master's novel "satisfactory" lotion test or the "competitive struggle" test as criteria to be applied in testing an inventor's date of invention, nor did the Court of Appeals affirm the statements below that Grant had arrived at the generic invention before McDonough. It simply held that McDonough was not entitled to a generic date of invention prior to knowledge of the species by Grant and Martin although McDonough had also invented the same species before Grant and Martin (20a). This simply gives rise to Question 5 of the petition.

Question 6

R. Br. 15:

Miller v. *Eagle* merely distinguishes objectives and effects from instrumentalities in patent claims. Applying the *Miller* v. *Eagle* case to the logic and rationale of the decisions below, how can an instrumentality designed for and taught to be used for permanently waving human hair without damage infringe a depilatory patent with claims defining and teaching instrumentalities for destruction of human hair or vice versa?

Question 7

R. Br. 17:

See Petition pages 44-46.

Questions 8 and 9

R. Br. 18:

Respondents' brief, in stating that the Court of Appeals did not hold that there was no evidence in the record that the Patent Office had determined that the application contained patentable subject matter, is directly in the teeth of the Court of Appeals decision which states: "The defendant by brief asserts that the proofs show that prior to Grant's protest the 'Examiner had withdrawn his rejection of McDonough's claims and had held the subject-matter of the application to be patentable'. *We find in the record no evidence whatever to support this assertion*" (Pet. 26a).

Respondents have no answer on the merits to the issues raised by "Question 8" and seek to avoid that fact by misrepresenting to this Court the plain language of the opinion of the Court of Appeals. It is therefore not necessary to repeat petitioners' argument set forth on pp. 51-55 of the petition.

R. Br. 19:

Respondents offer no answer to the detailed undisputed evidence, ignored by the Master, District Court, and Court of Appeals, establishing that the Patent Office indicated that the application for a patent was formally allowable.

The Courts below never commented upon petitioners' evidence so detailed but ignored it as is evidenced by the Court of Appeals holding that "there was nothing in the record to show" such facts (Pet. 24a).

R. Br. 20:

While the District Court below discussed the evidence relating to *some* misrepresentations, that same Court completely ignored the misrepresentations established by undisputed evidence. For the Court below to disagree with petitioner on the question of discharging its burden of proof as to some misrepresentations when this is some conflict in the evidence is readily understandable. But to do so with respect to *all* misrepresentations is a denial of justice where it appears that there is no such basis for the District Court's findings in view of the fact that petitioners' evidence with respect to the misrepresentations set forth on page 55 of the petition is undisputed.

The Master and District Court discussed the alleged weak misrepresentations. They were strangely silent as to those misrepresentations sustained by undisputed evidence. The Court of Appeals in its opinion because of its failure to apply the law and proceeding on a false premise as to the content of the record, never got to the question of proof of misrepresentations. These rulings below constitute such a departure from established judicial procedure as to invoke the exercise of the corrective powers of this Court by way of certiorari.

Conclusion

As shown by our petition for certiorari, the character of the four cases and the unusual nature of the issues presented by the decisions below particularly justify the exercise of the certiorari jurisdiction of this court. The response has failed to present any substantial opposition. Accordingly, the petition should be granted.

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(*Main Brief, Page 33*)

* * *

The District Court and the Master found:

> "that neither the original application nor the patent discloses or teaches that any particular factor—be it pH, concentration, molecular weight, or kind of base—is critical in mercaptan permanent waving (Master's Report, p. 21)." (At. Ax. 2969)

The basic error is that a patent applicant need not denominate any element of his invention as critical provided such element is critical in fact. If the compositions which the applicant discloses give results which in fact are different in kind from the results of the prior art, he has satisfied the law by teaching and delineating the new *thing* which he invented. It is immaterial whether or not he appreciates all its virtues. He need not even understand why it is a better thing—he need only reveal it and teach what the limits are, *Westmoreland Specialty Co. et al.* v. *Hogan, supra.*

As we have shown McDonough's *compositions and the limits given* for formulation thereof, as disclosed embody features which give results different in kind from those of the prior art. In that sense at least the patent discloses critical differences from the prior art. Consequently, it would make no difference whether McDonough's application said "these features are critical", or whether he merely disclosed an operative series of formulae or ranges which in fact critically distinguish from the prior art by their results.

Secondly, the Master and the District Court erroneously applied a wrong and a false standard to the disclosure of criticality in the McDonough patent. If *any* limit within which the claimed subject matter is drawn be a critical one, then the claims are patentable. It is not necessary and we do not believe the District Court intended to hold that every limitation in the claims must

* * *

(*Main Brief, Page 37*)

Original claim 30 was limited to the pH of about 9.2 (At. Ax. E. 106). Comparison of these original two claims with the claims of the patent in suit shows that McDonough from the beginning was asserting the patentable nature of his pH range and the weak, volatile bases and also the preferred pH value of "about 9.2". The claims in suit differ from these original ones only in that the limits claimed are somewhat narrower, but defendant's assertions and proofs as to criticality of the subject matter have never changed.

Applying the proper standards as to evaluation of the prior art and the existence of critical differences in kind between same and the invention, it is obvious that the lower tribunals made a basic error in holding the patent invalid for lack of invention.

III—As to Questions 5 and 6 *Re* the Prior Art

The decision of the District Court (At. Ax. 3240) confirmed the Master's findings that the McDonough patent was anticipated by the second Speakman U. S. patent (No. 2,261,094) and Speakman Canadian patent; by U. S. patent to Pye; and by the McDonough and Evans U. S. depilatory patent; also finding lack of invention over these patents and that of Maeder's Australian patent No. 17990/34.

A. The Second U. S. Speakman Patent

Grievous errors of law were made in the application of this patent as prior art. The principal holdings of both the Master and the District Court were based upon *claim* 7 of that patent as issued. Claim 7 specified a method of waving with alkaline solutions of an organic hydrosulfide. The Court's opinion (At. Ax. 3242), stated:

> "'This claim,' as the Master found, 'reads directly upon all the claims of the patent in suit' since 'alkaline' solutions include all solutions above pH 7, and mercaptans are *within* the definition of 'organic hydrosulfides.'"

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missed the boat so far on his predictions of what was a useful pH range that it was only after McDonough's composition became available to the public that Helene Curtis and Grant came in position to and did market a comparable composition.

Thus the Master's report is rife with loose and unsupported statements concerning the activities of Martin and Grant—activities which were not proved in any way remotely satisfying the established standards of prior use evidence. The Master accepted at face value the wholly unsupported oral testimony of Martin—testimony which not only failed to be corroborated by contemporary records, but which in fact is quite contrary to the records produced—yet the Master found this loose self-serving testimony of Martin sufficient to destroy McDonough's patent. Simultaneously he essentially disregarded the voluminous recorded evidence and testimony of corroborating witnesses proving that McDonough had conceived the very species attributed to Martin and Grant, reducing it to practice in 1937, in 1938, in 1940 and again in 1941, all prior to his filing date. These findings are a complete distortion of and a travesty upon the rudimentary legal requirements regarding prior use and prior invention evidence.

D. McDonough Is the Prior Inventor

The Master reasoned that because McDonough took a long time to round out the development on which he started in 1935, that he compared unfavorably with Martin and Grant. The Master also stated: "Sales Affiliates, as I have already noted, was left behind in the competitive struggle" (At. Ax. 3027). These reasons are strange ones for evaluating priority of invention. The new patent statute plainly and justly says:

> "Patentability shall not be negatived by the manner in which the invention was made." 35 U. S. C. 103

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(*Main Brief, Page 63*)

"of all the people working in the field of mercaptan waving during this period, it took McDonough longer to conceive and to develop a satisfactory waving lotion than anyone else." (At. Ax. 3026)

The record shows without contradiction that Dr. McDonough had many eminently satisfactory mercaptan waving lotions before Grant or Martin ever entered the field. Furthermore, McDonough's proof satisfies every requirement of the law in contrast to the utterly fictitious and wholly uncorroborated testimony of Martin.

To put it another way—if McDonough were put in interference with Grant on the specific thioglycolate ammonia subject matter based on Grant's work in late 1940 and 1941, McDonough would have won the interference because of his prior work. The same goes for Martin. But neither Grant nor Martin could have even been put in interference with McDonough on the generic invention in suit, because neither of them conceived or disclosed or used said genus.

The adverse findings further disregard the uncontested proof that in February, 1941, McDonough, or McGoldrick, repeated a whole series of tests with the newly-synthesized thioglycerin (At. Ax. 2437-9 re McGlodrick expt). This work confirmed his prior conclusions with other mercaptans and Evans directed that a patent application be prepared covering the class of mercaptans, noting the best pH range to be 8-9 (At. Ax. E. 1385). McDonough had the second draft of his patent application written by Graham beginning in March, 1941 (At. Ax. 2453-6, E. 1544-1558). This document is almost identical in disclosure with the patent in suit. The final work done with the test-tube immersion system by McDonough, McGoldrick and Hillier from April to June 16, 1941 was a refinement and recapitulation of his earlier work, specifically directed to fitting the precise operating requirements and technique of Glemby's Willat equipment and operators (At. Ax. 2437, 2444). Notably the solution ultimately adopted for commercial use in June was identical with

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sition is wholly consistent with the testimony of Snell and of McDonough that some loose curls can be obtained at and above pH 10 and with Brown's testimony that these loose curls are "satisfactory" in a subjective sense to a limited market. On the other hand defendant's evidence and tests are wholly consistent in showing that when it is attempted to obtain curls of maximum tightness the damaging effect of high pH lower the quality of the wave at and above pH 10.

P. Br. page 29: The Prior Art

The assertion that we made no argument as to lack of invention is absurd. We have met the very point on which lack of invention was predicated, *i.e.* the criticality point. This is sufficient to distinguish from the first Speakman patent as well as Pye, Maeder and the depilatory patent.

P. Br. pages 31-32: Second Speakman Patent

1. Neither the Court nor the Master held that this patent showed cysteine hydrochloride at pH 8. The matter of claim 7 is adequately covered in the main brief. The second Speakman patent was before the Board of Appeals and before the 4915 Court. It was re-cited in the Examiner's Statement (Ex. P 2, Vol. IV, pp. 923, 927). For further discussion see "unclean hands", *infra.*

P. Br. page 33: McDonough's conception of cold waving with mercaptans was recorded in the memorandum of October 4, 1935 (At. Ax. E 1533).

P. Br. page 35: As to Speakman Canadian the decisions* in plaintiffs' footnote are irrelevant to the non-anticipatory effect of an invention disclosed but not *claimed* in a foreign patent which is not a printed publication.

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* **Sirrocco** v. **Sturtevant,** 220 Fed. 137, the French patent involved had no claims, the entire disclosure constituting what is "patented" under French law. The court held that the anticipating structure was **patented** in France. See also **Gen. Electric** v. **Alexander,** 280 Fed. 852, 854 (C. A. 2nd 1922). The French, Italian and German patents in the other cases cited in the footnote were all **printed publications** so the point does not arise. See also **Ex parte Haller,** 103 USPQ 382 (1954), holding that a typewritten public Australian patent application is not a "printed publication" under 35 U. S. C. 102.

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NOV 16 1956

JOHN T. FEY, Clerk

IN THE

Supreme Court of the United States

October Term 1956

No. 333

SALES AFFILIATES, INC.,

Petitioner,

vs.

HELENE CURTIS INDUSTRIES, INC., HELENE CURTIS SALES, INC., THE GILLETTE COMPANY, *et al.*,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING CERTIORARI

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November 16, 1956

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PETITION FOR REHEARING OF ORDER DENYING CERTIORARI

Petitioner prays that this Court grant a rehearing of its order of October 22, 1956 denying petition for a writ of certiorari and that a writ of certiorari issue to review the judgment of the Court of Appeals for the Second Circuit, as prayed for in the petition filed August 20, 1956.

This petition for rehearing advances grounds for granting certiorari not presented in the original petition which are of great importance to our Federal judicial system and all litigants in the United States District Courts.

The grounds for seeking a rehearing are two:

1. The public importance of the decisions below which accord to the District Courts an unbridled power to sub-

stitute "fair and proper" judicial trial *in gross* for a specific right, *e.g.* oral summation, an element of the procedural due process guaranteed by the Constitution of the United States.

2. The prejudicial effect on litigants in the Federal trial courts of the expansion and extension of the WJR decision to all judicial proceedings.

Substitution of "Fairness" in Gross for Specific Constitutional Rights

The Bar generally has watched with intense interest the progress of this case through the courts.

The constitutional question of lack of oral summation is not limited to patent cases.

The Court of Appeals decision is particularly discomforting to advocates of procedural due process because it substitutes a new approach for time honored judicial protection of specific constitutional rights.

The Court of Appeals held that the defendant had "been accorded all the requirements of a fair and proper trial" (Pet. 31a). On this generalized concept, the Court affirmed the denial of a specific element of procedural due process, *i.e.*, oral summation, which amounts to a denial of constitutional rights. This criterion sacrifices the individual rights considered so common to fundamental fair play that they have been made essential parts of the constitutional expression "due process"; and the justification for this sacrifice is the novel nebulous general concept of "fair and proper" trial as a whole.

Nowhere did the Court of Appeals discuss the question of whether the specific constitutional right of oral summa-

tion existed, nor did it discuss whether defendant intended to waive such right or had in fact waived such right. The rules governing waiver were never mentioned. These are the principles which persons interested in the constitutional guarantees of our system of jurisprudence have believed fundamental.

Instead, the Court of Appeals found:

(a) Defendant had expressly requested oral summation at the close of the trial before the Master and indicated its continued desire for summation on May 14, 1953 (to which the Master agreed); but, because both defendant and the Master were silent in the eight months thereafter, the trial was "fair and proper."

(b) Because the defendant did not file petition for reconsideration before the Master after the damage had been done, the *trial* was "fair and proper."

(c) Because defendant did not use arguments or briefs to elaborate the point in the District Court on review of defendant's Objection B* to the Master's Report, the *trial* was "fair and proper."

(d) The District Court's *ex post facto* rationale that lack of summation at the close of the evidence was insubstantial, because oral arguments were afforded in the *review proceedings* in the District Court (after the presumptive correctness of the Master's findings had attached under Rule 52) was affirmed in principle by the Court of Appeals if not expressly affirmed *in haec verba.*

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* Objection B asserted that the "Special Master erred in submitting and filing his Report on January 13, 1954 without permitting counsel an opportunity to make an argument". (D. A. 3090)

(e) And finally, because in the Court of Appeals defendant did not spell out arguments that could have been made in addition to those appearing in the written briefs submitted to the Master, the *trial* was "fair and proper."

These reasons are not germane to the denial of a constitutional right.

If allowed to stand unchecked, the decision below will permit trial courts freely to require written briefs as a means of avoiding oral summation of the evidence. The one constitutionally guaranteed opportunity to actually confront the trier of fact face to face with the litigant's view of the case is side-tracked to the bottom of the judge's pile of paper work accumulated in chambers. If this specific element of due process can be withheld by judicial substitution, caprice can invent other substitutions which will place all specific constitutional rights in a limbo beyond reach of litigants.

If the decisions below stand unchecked, demand and desire for oral summation expressed at the close of the evidence are of no effect. The trier must be continuously nagged and reminded up to the moment of decision. Moreover, the right to trial summation not only must be preserved but also must be continuously and vigorously reasserted *ad nauseam* through proceedings in the Courts of Appeals—not because the right is otherwise waived but because the trial was "fair and proper". This *ex post facto* destruction of one constitutional guarantee is a dangerous precedent which will lead to erosion of other constitutional rights.

The Injury to Defendant on the Merits

The fundamental error below intimately affected the entire merits of the defendant's case. The findings that were made by the Special Master without the benefit of oral summation would not have been made. At this juncture the injury to the defendant was complete in that the Master's findings were accorded by the District Court (see opinion, D. A. 3231) that presumption of validity prescribed by Rules 52 and 53(e)(2) of the Federal Rules of Civil Procedure as interpreted by this Court in numerous cases. From that point on, the defendant was confronted with the almost insurmountable barrier of overturning findings of fact made by the Special Master which were armored by the "clearly erroneous" rule. These findings of fact dealt with the date of invention, which in turn determined the prior art available against the invention, with the authenticity of prior inventions, uses and sales, the performance differences between the invention and the prior art, and the scope and meaning of the patent claims to the statutory man skilled in the art. (See the original petition, pages 26-46.) These findings of fact in the above particulars circumscribed the entire merits of the petitioner's patent case as well as the counter-claim.

Effect on Judicial Procedure Generally

The impact of the decisions below on ordinary trial practice is glaringly revealed by reference to *Federal Communications Commission* v. *WJR*, 337 U. S. 265, 274-277, discussed at pages 17-19 of our original petition. In the

very narrow and special circumstances of that administrative agency case, this Court held that oral argument on a demurrer was not an essential element of procedural due process.

But the decisions below stretch and enlarge the narrow result intended in the WJR case to the point where all judicial proceedings are engulfed.

The published opinions below set forth in the name of the WJR case the rule that oral argument is not required *as summation* in a court trial lasting six months and involving 6000 pages of testimony and several thousand pages of exhibits raising hundreds of complicated issues of fact and law. If oral summation is not a required element of procedural due process in such a case, what litigant can rely on enforcement of the guarantee of summation in any case?

This Court has always been alert in the past to prevent unwarranted and mischievous extensions by the lower courts of its interpretations of the Constitution, with particular emphasis laid in the field of procedure touching the preservation of a litigant's right to notice and hearing. The present case is a clear instance where certiorari jurisdiction should be exercised.

In addition, our judicial machinery for just disposition of claims and controversies is erected not only on full notice and hearing but also on the adversary concept of litigation. The Bench is in large part dependent upon a wise and resourceful Bar. The lawyers, as officers of the court, are expected to provide the study and knowledge of the individual case which the judge can never supply for himself. We respectfully submit that the right of oral

summation, and the opportunity it affords to litigants and the courts alike, stands astride this fundamental basis of Anglo-American jurisprudence. Destruction of this right below is a departure from constitutional principles which will have injurious effect of the most serious kind on the federal trial courts generally as well as on all litigants in those courts.

Conclusion

For the reasons set forth above and in the petition for a writ of certiorari, it is respectfully urged that a rehearing be granted and that upon such rehearing, a writ of certiorari issue to the Court of Appeals for the Second Circuit.

Respectfully submitted,

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November 16, 1956

Certificate of Counsel

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay, and is restricted to grounds specified in Rule 58(2) of the Rules of this Court.

November 16, 1956

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